SUPREME COURT, U. S.

Supreme Court, U.S.
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IN THE

# Supreme Court of the United States

OCTOBER TERM, 1971.

No. 71-103

THE GOODYEAR TIRE & RUBBER COMPANY,
*Petitioner,*

*vs.*

H. K. PORTER COMPANY, INC.,
*Respondent.*

## PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT.

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## PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT.

Petitioner, The Goodyear Tire & Rubber Company, prays that a Writ of Certiorari issue to review the judgment of the United States Court of Appeals for the Sixth Circuit in the above-entitled case.

### OPINIONS BELOW.

The opinion of the Court of Appeals in this case is reported at 437 F. 2d 244 and is reprinted in the appendix to this petition, at page A1. The Court of Appeals affirmed the judgment of the District Court for the Northern District of Ohio, Eastern Division, Judge Thomas D. Lambros presiding. The lower court opinion is reported at 163 U. S. P. Q. 106 and is reprinted in the appendix to this petition at page A8.

## JURISDICTION.

The judgment of the Court of Appeals was entered on January 27, 1971. A timely petition for rehearing was denied, without comment, on April 16, 1971. The jurisdiction of this court is invoked pursuant to 28 USC Section 1254(1). The basis of jurisdiction in the District Court was 28 USC Section 1338(a) and 1400(b).

## QUESTIONS PRESENTED.

This is a patent infringement action in which a main defense against the patent involved the weight and interpretation to be given to a prior judgment by the Patent Office Board of Patent Interferences, a quasijudicial administrative board charged by law with the determination of priority of invention as between two contestants. Specifically the questions presented herein are:

1. Whether the Court of Appeals for the Sixth Circuit, in view of the rule announced by this Court in *Blonder-Tongue Laboratories, Inc.* v. *University of Illinois Foundation et al.*, erred in failing to consider petitioner's plea against respondent as an estoppel based on a prior decision by the Patent Office Board of Patent Interferences, on the same issue presented to the Courts below?

2. Whether the Court of Appeals for the Sixth Circuit erred in failing to apply a count of a patent interference as prior art for what it plainly states on its face, and for what it clearly teaches the reader as though it were a page in a text?

The first question involves an important question of federal law which has not been, but should be, settled by this Court. The second question involves a decision below which has decided a federal question in conflict with applicable decisions by this Court and others.

## INTRODUCTORY STATEMENT.

This petition raises squarely for consideration by this Court the same questions which were considered and resolved by this Court in *Blonder-Tongue Laboratories, Inc.* v. *University of Illinois Foundation et al.*, ..... U. S. ....., 169 U. S. P. Q. 513 (May 3, 1971), except, in this instance, the prior decision is a judgment by the Patent Office Board of Patent Interferences rather than a decision by a Federal Court. It will be brought out hereinafter that, in every respect, the present petition parallels the facts in *Blonder* once the judgment by the Board of Patent Interferences is accepted. All of the logic and reasoning advanced by this Court in *Blonder* is equally applicable to a decision rendered by the Board of Patent Interferences and should equally support a plea of estoppel based on said prior decision.

As the Supreme Court reasoned in *Blonder:*

> "The broader question is whether it is any longer tenable to afford a litigant more than one full and fair opportunity for judicial resolution of the same issue."
>
> • • • • •
>
> "In any lawsuit where a defendant, because of the mutuality principle, is forced to present a complete defense on the merits to a claim which the plaintiff has fully litigated and lost in a prior action, there is an arguable misallocation of resources."
>
> • • • • •
>
> "Permitting repeated litigation of the same issue as long as the supply of unrelated defendants holds out reflects either the aura gaming table or 'a lack of discipline and of disinterestedness on the part of the lower courts, hardly a worthy or wise basis for fashioning rules of procedure.'" (..... U. S. ....., 169 U. S. P. Q. 519.)

Should not the theory of *Blonder* be extended to include a decision by the Patent Office Board of Patent Interferences—that is, that a defendant may plead estoppel based on a prior decision by the Patent Office Board of Patent Interferences?

At the least, petitioner should be allowed to plead estoppel and then the respondent would have the opportunity to demonstrate, if it can, that it did not have "a fair opportunity procedurally, substantively, and evidentially to pursue its claim the first time",—i.e. when the issue of prior inventorship was thoroughly considered and decided by the Patent Office Board of Patent Interferences.

This petition also raises a second question, about which there appears to be much dispute. That is, should the count of an interference be read as though it were a page in a textbook and taken for what it clearly says, or must it be limited and interpreted to the narrowest scope that can be found for it in the contemporaneous record?

The holding by the Court of Appeals for the Sixth Circuit in the present case as to the interpretation to be given a count in an interference, is opposite the law as expressed by the Court of Customs and Patent Appeals in several recent cases, such as *In re Risse*, 378 F. 2d 948, 956 (CCPA 1967), and its own expression in *Maxon* v. *Maxon Construction Co., Inc.*, 395 F. 2d 330 (6th Cir. 1968), all of which hold that a count of an interference (or patent claim) must be given the broadest construction which it will reasonably permit.

## CONSTITUTIONAL PROVISIONS AND STATUTES INVOLVED.

The constitutional provision and statutes involved herein are:

1. Constitution of the United States, Article I, Section 8:

"The Congress shall have power . . . to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries; . . ."

2. The Patent Act, 35 U. S. Code Section 102(a) and (g):

"A person shall be entitled to a patent unless—(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or (g) before the applicant's invention thereof the invention was made in this country by another who has not abandoned, suppressed or concealed it. . . ."

3. The Patent Act, 35 U. S. Code Section 135. Interferences:

"(a) Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be. *The question of priority of invention shall be determined by a Board of Patent Interferences (consisting of three examiners of interferences) whose decision, if adverse to the claim of an applicant, shall constitute the final refusal by the Patent Office of the claims involved,* and the Commissioner shall issue a patent to the applicant who is adjudged the prior inventor. . . ."

## STATEMENT OF THE CASE.

In 1965 H. K. Porter Company, Inc. (hereinafter called Porter) the respondent in this case, filed suit charging petitioner, The Goodyear Tire & Rubber Company (hereinafter referred to as Goodyear) with infringement of two of its patents, U. S. Patent No. 3,050,087 (PX 1) and U. S. Patent No. 3,194,705 (PX 2), both issued to one David Caplan, and assigned to H. K. Porter.*

While there are two Caplan patents in suit, there is really only one inventive concept involved. Indeed, Caplan originally filed a single application for patent but for procedural reasons the United States Patent Office required the application to be divided into two separate applications, one for the method of making hose and the other for the hose per se. The subject matter is a flexible hose used as replacement hose on an automobile radiator. A page of drawings from U. S. 3,194,705 is illustrative of such hose, and is included on the opposite page. The hose is flexible and molded into a corrugated shape. It is made of rubber and has a helical reinforcing wire coil embedded in the rubber body to give it strength. Both Porter and Goodyear were making hose of this general character in 1965 when the suit was brought, but Porter has since gone out of the hose business.

The District Court held certain claims of the patents valid and infringed by Goodyear and adopted almost verbatim some 56 findings of fact and 26 conclusions of law which had been written by the plaintiff.

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* References marked A. .... are to pages in the Appendix. References marked PX. .... and DX. .... are to plaintiff's and defendant's trial exhibits, respectively, copies of which are included in a separate Exhibit Volume. The Exhibit Volume contains an index to facilitate location of particular exhibits.

July 13, 1965 D. M. CAPLAN 3,194,705

METHOD AND APPARATUS FOR MAKING REINFORCED CORRUGATED HOSE

Original Filed Feb. 1, 1954 6 Sheets-Sheet 1

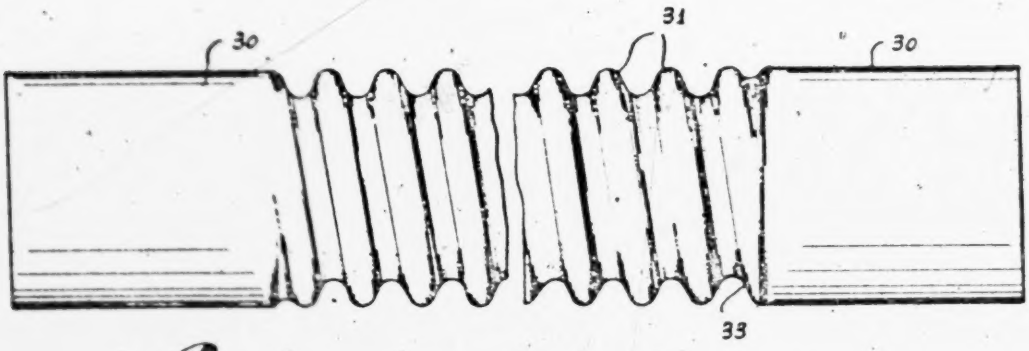


Fig. 1

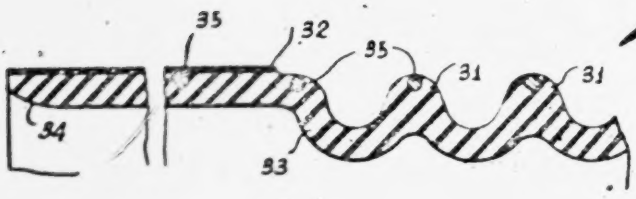


Fig. 2

Fig. 3

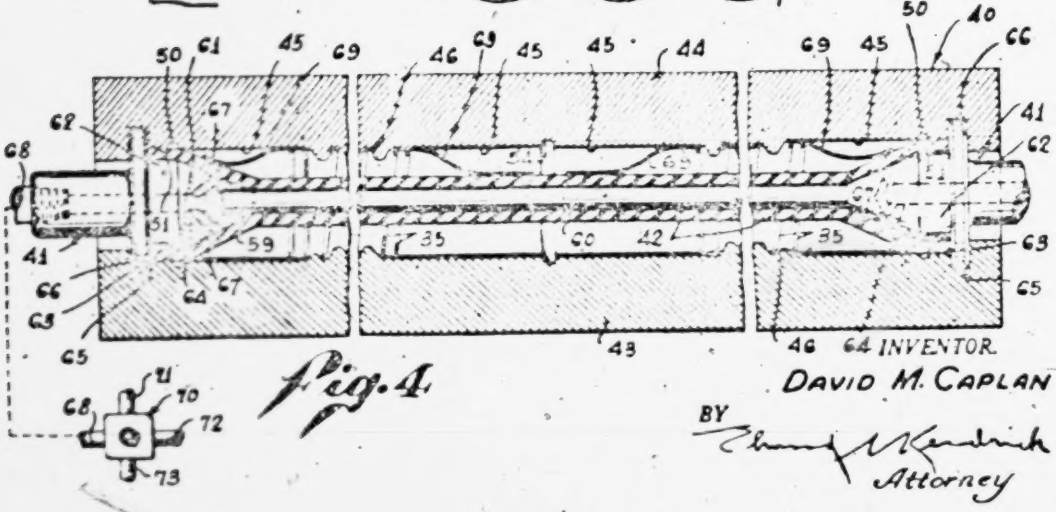


Fig. 4

INVENTOR.
DAVID M. CAPLAN
BY
Attorney

On appeal to the Court of Appeals for the Sixth Circuit, Goodyear asserted as one of its main grounds that Count One of Interference No. 91,640 (which is identical with claim 16 of Roberts U. S. Patent No. 2,936,812) was effective prior art which barred the issuance of the patents to Caplan. Caplan said his process was described by the count but he had been declared the loser by the Patent Office Board of Patent Interferences in a contest over priority as to that invention. The Court of Appeals apparently agreed with Goodyear's reasoning in all respects except that it held the Caplan process was inventively different from the Roberts '812 patent.

This holding by the Court of Appeals cannot stand:— because the Patent Law re interferences demands that the Caplan process and Roberts process had to be the same in order to interfere. It was up to Caplan to declare himself and he did so vigorously. He insisted that Count One defined his process as well as Roberts', that they were one and the same, and that he was the first to invent.

But he was wrong on priority. After full hearing comparable to a trial, Caplan was declared the loser. He was not the first inventor of the subject matter of the Count,— and, since there is no such thing as a second inventor, Caplan was no inventor at all.

The Count, about which much will be said in this Petition, is simple and easy to understand. It reads:

*COUNT ONE.*

A method for the manufacture of reenforced spirally corrugated hose which comprises

(a) forming a tubular member of elastomeric material,

(b) positioning thereover a reenforcing member having axially spaced turns,

(c) positioning said tubular layer with said reenforcing member thereon *within a hollow internally corrugated mold* with said turns in alignment with and positioned within said corrugations,

(d) and subjecting said tubular member to *internal pressure accompanied by heating to cause it to expand and soften and conform to the shape of said mold* while simultaneously flowing around and embedding said turns therein.

The "tubular member . . ." is a smooth-bore rubber tube and the "reenforcing member" is a coiled wire spring. Note that section (c) refers to a hollow mold while section (d) recites heating and expanding the tube to conform to the shape of the mold. This is simply "mold-forming", and the heating causes the rubber to vulcanize (or cure).

Had the Court of Appeals read Count One literally as though it were a page in a textbook, it would have found that the Count clearly recites a mold-forming operation in which the hose is molded and cured at the same time. Instead the Court of Appeals chose to engage in a strained interpretation of the plain language of the Count and to limit it very specifically to a preferred embodiment of the invention which Roberts had disclosed in order to teach the details of it. Thus the Court of Appeals erroneously found the Roberts' invention as defined in Count One of the interference was limited to a two-step method of (1) preforming the hose in corrugated shape and (2) then placing it in the mold for vulcanization. Having thus so narrowly interpreted the interference Count, the Court of Appeals found the Caplan patents valid over it.

## ARGUMENT RE QUESTION ONE:

### THE INTERFERENCE PROCEEDINGS WHICH THE COURTS BELOW HAVE MISINTERPRETED OR IGNORED.

Petitioner maintains, and the courts below apparently have agreed, that Count One of Interference 91,640 is available as prior art against respondent's patents. Thus if Count One defines the *same* invention as respondent's patents, the patents are invalid.

The foregoing Count One (p. 7) originated in Robert E. Roberts U. S. Patent No. 2,936,812 on May 17, 1960 as a broad claim (No. 16) to the process of simultaneous mold-forming and curing of corrugated hose (see a copy of Roberts '812 at p. 171 of Exhibit Volume). Caplan copied this claim into his pending patent application and provoked an interference in the U. S. Patent Office for the specific purpose of taking this claim away from Roberts. At law, by copying the claim, Caplan admitted that Count One of the interference defined his invention. This is not a vague, general admission that can be passed over lightly. Rather, to comply with Rule 205(b) of the Patent Office Rules of Practice, Caplan had to make a specific admission, "... and specifically apply the terms of the copied claim to his own disclosure, ...".[1] A patent interference can begin only on the premise that there is a contest over priority as to a particular, well-defined invention. Identity of invention is a prerequisite and the sole question in a patent interference is priority.

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1. Rule 205(b) reads in pertinent part as follows:

"Where an applicant presents a claim copied or substantially copied from a patent, he must, at the time he presents the claim, identify the patent, give the number of the patented claim, *and specifically apply the terms of the copied claim to his own disclosure*, unless the claim is copied in response to a suggestion by the Office."

The Patent Office Board of Patent Interferences considered extensive testimony, documentary evidence and briefs, heard oral argument and then issued its administrative decision that:

> "Upon the facts above reviewed and in view of principles stated, we hold that Roberts is the *original inventor of the invention defined in counts 1*, 3 and 4." (Ex. Vol. p. 140 g and h) (emphasis added).

The decision is conclusive and final that Caplan did not invent the subject matter of Count One of Interference No. 91,640. Respondent could have appealed this decision if it disagreed—but elected to let the decision stand.

The problem then resolves itself into the question:—What is the invention defined in Count One of the Interference? Whatever the invention was, it was defined by Count One, and Caplan alleged it was *his* invention. Indeed, Caplan is now estopped to deny that his alleged invention is the same as Roberts' as defined in Count One, because he could not, at law, have provoked the interference if his invention had been different from Roberts.

Yet, mistakenly, the Court of Appeals for the Sixth Circuit analyzed the situation as follows:

> ". . . *the Roberts hose is preformed and hand-corrugated* on a mandrel and then placed in a mold for curing and vulcanization. This process may be referred to as mold-curing. *The Caplan hose*, on the other hand, *is mold-formed* by putting the separate components in a mold, in which they are molded and vulcanized in the same operation." 437 F. 2d 246 (Emphasis added.)

Thus the Court of Appeals drew a distinction between (a) the two-step process of preforming hose into corrugated shape and then placing it in a mold to mold-cure it, ascribed to Roberts, and (b) the one-step process of simultaneously

mold-forming to corrugated shape and curing, ascribed to Caplan.

It must be noted however that Count One does not support the Court of Appeals analysis of the Roberts' process because it reads unambiguously as follows:

*COUNT ONE.*

A method for the manufacture of reenforced spirally corrugated hose which comprises

(a) forming a tubular member of elastomeric material,

(b) positioning thereover a reenforcing member having axially spaced turns,

(c) positioning said tubular layer with said reenforcing member thereon *within a hollow internally corrugated mold* with said turns in alignment with and positioned within said corrugations,

(d) and subjecting said tubular member to *internal pressure accompanied by heating to cause it to expand and soften and conform to the shape of said mold* while simultaneously flowing around and embedding said turns therein.

There is nothing in the plain language of this Count that limits Roberts to the two-step process (*supra*) which the Court of Appeals calls mold-curing. On the contrary, the Count reads clearly on the one-step process of mold-forming and curing.

Applying the law of interferences, it is axiomatic that respondent cannot maintain that the Count embraces the two-step or mold-curing process, because Caplan insisted that his one-step or mold-forming process is the same as the Count. Indeed, if the Count embraced only the two-step method, Caplan never could have provoked the Interference since he does not disclose a two-step method.

This Court should look to the expert Board established

within the Patent Law for its version of the invention and the proofs offered by the parties. The Patent Office Board of Patent Interferences reviewed the extensive testimony and proof that was presented in Interference No. 91,640, and plainly stated the true scope of the Roberts invention in the following terms:

> "Thus while the contemporaneous documents do not say, in those very words, that subjecting the tubular member inside the spring to pressure and heating causes it 'to expand and soften and conform to the shape of said mold while simultaneously flowing around and embedding' the turns of the spring therein, this appears to be the only reasonable conclusion to be drawn from their descriptions." (Ex. Vol. p. 131)
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> • • • • •
>
> "We accordingly believe that in Roberts' concept in the first half of 1949 as disclosed by *contemporary documents,* the inner tubular member, under internal pressure and heat, would expand and soften conforming to the shape of the mold while flowing around and embedding the spring. This is supported also by the oral testimony of Roberts (R 27, 28, 57 to 71, 576, 577), his father (FSr. 25, 34, 70) and his brother (FJr. 57 to 60). *We therefore hold that Roberts has established that he conceived the invention defined in counts 1 and 3 during the first half of 1949.*" (Ex. Vol. p. 133)
>
> • • • • •
>
> For reasons similar to those considered with respect to conception, *this evidence by a corroborating witness is deemed to establish disclosure to the Voit company of the method defined in counts 1, 3 and 4.*" (Ex. Vol. p. 139-140)
>
> • • • • •
>
> "The fact that Caplan had a different specific method, omitting the covering of the spring with a layer as in Roberts' method, does not aid Caplan in a contest involving orginality of the generic invention (*Laughlin* v. *Burry,* 50 App. D. C. 273, 270 Fed. 1013, 1921 C. D. 180, 286 O. G. 1060).

"Upon the facts above reviewed and in view of principles stated, *we hold that Roberts is the original inventor of the invention defined in counts 1, 3 and 4.*" (Ex. Vol. p. 140g and h)

This decision by the Board of Patent Interferences is entitled to the same weight as a decision by a court, and qualifies as the ". . . one fair and full opportunity to prove a claim . . ." that this Court referred to in *Blonder-Tongue Laboratories, Inc.* v. *University of Illinois Foundation,* 169 U. S. P. Q. 518.

Respondent, having thoroughly exploited the issue of inventorship of "mold-forming" of hose in the Interference, and lost, then pursued the same issue in the present litigation at the district court level. That is, respondent now claims that Caplan, not Roberts, was the first inventor of mold-forming of corrugated hose, and has persuaded the courts below to ignore the prior adjudication by the Board of Patent Interferences to the contrary.

The reasoning by the Supreme Court in *Blonder* is equally applicable to a decision rendered by "an administrative court", or expert, quasi-judicial body such as the Patent Office Board of Patent Interferences, and should support a plea of estoppel based on a prior decision by such "administrative court" on the same issue.

In the present case each of the elements that pertained in *Blonder* is found fully satisfied herein:

(1) Was the issue decided in the prior adjudication the same as the one presented in the present action? Yes, the issue in both instances is who was first to invent the mold-forming process for making corrugated hose.

(2) Was there a final judgment on the merits? Yes. The Patent Office Board of Patent Interferences,

acting at law as charged by 35 U. S. C. 135,[2] decided that Roberts, not Caplan, was the first inventor of the mold-forming process. Respondent could have appealed but did not.

(3) Is respondent the same party who asserted the same issue in the prior adjudication?
Indeed yes, it was H. K. Porter Co. the owner of the Caplan patents.

Thus, contrary to *Blonder,* the courts below erred in failing to afford to the Patent Office Board of Patent Interferences' decision its due weight. At the least, the courts below should have allowed petitioner to plead estoppel. Then the respondent herein may demonstrate, if it can, that it did not have "a fair opportunity procedurally, substantively and evidentially to pursue his claim the first time", —i.e. when the issue of prior inventorship of mold-forming was thoroughly considered and decided by the Patent Office Board of Patent Interferences.

In summary re Question One, the decisions below are deficient and should be reversed, and/or remanded for specific hearing and findings on the above points.

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2. 35 U. S. C. 135 reads in pertinent part:

"... The question of priority of invention shall be determined by a board of patent interferences (consisting of three examiners of interferences) whose decision, if adverse to the claim of an applicant, shall constitute the final refusal by the Patent Office of the claims involved. ..."

## ARGUMENT RE QUESTION TWO:

## SHOULD AN INTERFERENCE COUNT BE READ LITERALLY AS THOUGH IT WERE A TEXT?

Petitioner contends that Count One of Interference 91,640 (which is the same as claim 16 of the Roberts '812 patent) is a clear, unambiguous, description of the method of making hose by the "mold-forming" technique. A person skilled in the art may read the method disclosed in said Count One and may easily make a piece of hose by following that method. Reference to the specification and drawings is unnecessary, and the claim should be read as though it were a page in a textbook, i.e., for what it can teach the reader.

The Court of Appeals reached an erroneous conclusion that the Caplan invention is inventively different from the Roberts invention as defined in Count One (and claim 16 of Roberts '812 patent). The Court held that the Roberts hose is preformed and hand corrugated on a mandrel and then placed in a mold for curing and vulcanization. This two-step process is referred to as mold-curing. The Caplan hose on the other hand is mold-formed by putting the separate components in a mold in which they are molded and vulcanized in a single operation. Thus the Court of Appeals completely ignores the plain language of Count One which reads in pertinent part as follows:

*COUNT ONE.*

A method for the manufacture of reenforced spirally corrugated hose which comprises

* * * * *

(d) and subjecting said tubular member to internal pressure accompanied by *heating* to cause it to expand

> and soften and *conform to the shape of said mold* while simultaneously flowing around and embedding said turns therein.

"Heating" results in curing (vulcanization), while conforming to the shape of the mold is synonymous with "mold-forming".

Hence, the Court of Appeals made an error of law when it failed to read Count One literally. In severely restricting the plain language of the Count, the Court of Appeals went contrary to the established decisional law on this point. This Court has affirmed that it is the claims of a patent which are the sole measure of the patent grant, *Aro Manufacturing Company* v. *Convertible Top Replacement Co.*, 365 U. S. 336, 339-340 (1961) and *Universal Oil Products Company* v. *Globe Oil and Refining Co.*, 322 U. S. 471, 484-485 (1944).

The Sixth Circuit Court of Appeals in *Maxon* v. *Maxon Construction Company, Inc.*, 395 F. 2d 330 (6th Cir., 1968) also has held that *patent claims are not limited to the embodiments depicted in the patent, as follows:*

> "While the specifications and drawings of Maxon's patent do describe and illustrate a rear dump body, Claim 15 contains no such limitation. The claims of a patent are not necessarily limited to the embodiment depicted in the patent. (authority cited.)
>
> "A patentee is only required to describe the best method of practicing his invention but he is not confined to that. If his claim is broad enough, he may claim infringement
>
> * * * * * *
>
> His claims are the measure of his invention."

Other courts have held likewise in cases on all fours with the present one. The Court of Customs and Patent Appeals, which is expert in this field, heard a case, *In re Field*, 161 F. 2d 372, 374 (1947), in which the appellant contended

that the Patent Office had not considered the *detailed disclosure* in the reference patent, but had improperly considered merely the *claims* of the patent in applying it as prior art. The CCPA said:

> "The subject matter defined by the claims of a patent cited as a reference is part of the disclosure of that reference and may properly be considered in determining the question of anticipation. *In re Smolak and McQuade*, 88 F. 2d 838, and authorities therein cited." (161 F. 2d 374.)

Exactly the same situation exists in the present case. Count One has been cited as a reference. It should not be limited to the detailed disclosure in the specification and drawings, but should be read for what it plainly discloses on its face.

It is well established that an unambiguous interference count must be accorded the broadest construction the language reasonably will bear, without recourse to the specification from which it originated. *Phillips* v. *Lynch & Larew*, 151 USPQ 400 (CCPA 1966); *Vogt* v. *McFeaters*, 341 F. 2d 315 (CCPA 1965); In *Phillips* v. *Lynch & Larew, supra*, the Court so held:

> "The counts are broadly drawn and not being ambiguous, must be given the broadest construction which they will reasonably permit."
>
> * * * * *
>
> "In the absence of ambiguity, it is neither necessary nor proper to look to the specific apparatus described in the Lynch et al. patent in the interpretation of the counts."

An unambiguous Count of an interference is to be read literally and applied for what it plainly states. This rule of construction has been affirmed by the Court of Customs and Patent Appeals in *Vogt* v. *McFeaters, supra*. In that interference case the Court said:

> "In so deciding, we consider the count unambiguous, as did both parties and the board, and accord it the broadest construction the language reasonably will bear without recourse to the specification from which it originated. See In re Kelley, 305 F. 2d 909, 134 USPQ 397."

The law is correctly stated in *In re Risse*, 378 F. 2d 948 (CCPA 1967) wherein the Court of Customs and Patent Appeals studied the development of the law on this problem and recognized that much confusion then existed. That Court made a comprehensive review and finally concluded:

> ". . . with regard to prior art (including prior invention), the losing party cannot obtain claims to subject matter which is either barred under 35 U. S. C. § 102(g), or rendered obvious under 35 U. S. C. § 103, by the invention defined in the interference counts."
>
> * * * * *
>
> "At a minimum, prior invention under section 102(g) includes the subject matter of the interference counts, which may be used as evidence of prior art under section 103. As this court stated in In re Cole, 82 F. 2d 405, 409, 23 CCPQ 1057, 1063:
>
> > 'We therefore hold, in harmony with our decisions hereinbefore cited, that in order to warrant the allowance of the claims before us the claims must be inventively different from said interference counts.'" (378 F. 2d 948, 957, 956) (Emphasis added.)

The Supreme Court is asked here to affirm that the law is as stated above by the Court of Customs and Patent Appeals rather than as applied in this case by the Sixth Circuit Court of Appeals. The "subject matter of the interference count" is prior art against respondent's patents, and petitioner will now show how the interference count leaves nothing for respondent to patent.

As detailed above, Count One of the Interference (cl. 16 of '812) is a clear description of the Caplan method. More importantly, *Caplan, at law, has conceded by his copying of claims* from the Roberts '812 patent and requesting an interference, *that he believed that his alleged invention and the method of the Interference Counts were one and the same.* Rule 205(b), Patent Office Rules of Practice.*

The Roberts invention, as expressed in Count One, is in mold-forming broadly, and thus plainly teaches and anticipates the respondent's process as that process is defined by the Court of Appeals. The following facts are conclusive on this point:

1. The Interference Count (Claim 16 of Roberts '812 patent, PX-76, Appendix *C*) defines in simple, unequivocal terms a straightforward method of making a "mold formed", corrugated, wire-reenforced hose, and this method does not include any step of corrugating the tubular member before it is placed in the mold.

2. The specification and drawings of the Roberts '812 patent (DX-L) include clear support for "mold-forming". For example, the Roberts '812 specification states that "Figure 12 is a fragmentary view . . . of a sectional mold and illustrating *a forming operation during setting*" (Column 2, lines 22-24). In the rubber industry, "setting" is synonymous with "vulcanizing" (curing).

3. The Board of Patent Interferences held the interference count to cover broadly the simultaneous mold-forming and curing process. Indeed, the interference counts must, by law, read on both the Roberts and Caplan inventions in order to support an interference; and the restrictive interpretation taken by the Court of Appeals would have excluded Caplan from the interference. Moreover, after analyzing extensive testimony and corroborating evi-

* *Supra*, p. 9.

dence in the interference record, the Board of Patent Interferences held:

> "that in Roberts' concept in the first half of 1949 as disclosed by contemporary documents, the inner tubular member under internal pressure and heat, would expand and soften, conforming to the shape of the mold while flowing around and embedding the spring." (Ex. Vol. p. 133).

Thus, the Board held that it was Roberts, and not Caplan, who invented "mold-forming" of hose.

4. Other claims of the Roberts '812 patent (Claim 15) are specifically directed to a two-step process of precorrugating a tube and then curing it in a mold. These claims were not included as interference counts for the obvious reason that Caplan could not support them and did not copy them. At law, Claim 16 is required to define something different from Claim 15.

5. Robert E. Roberts certainly did not consider his invention to be restricted to the two-step, hand corrugating process. Rather, he testified in unrefuted testimony (DX-M, pp. 66-69, 139-141) that he invented "mold-forming", as the Court of Appeals defines the term.

6. Respondent has not denied that Roberts' invention embraced Caplan's mold-forming process. Indeed, when Roberts sued respondent for infringement of the '812 patent, it settled by taking a license under the patent. If respondent honestly believed that Roberts' invention and patent were limited to a two-step process, it would not have taken an expensive license and agreed to pay Roberts some $200,000.

A patent claim or count of an interference is not to be limited to the preferred embodiment of the invention which the patent law requires an applicant to disclose as consideration for the grant of the patent. That is, the patent law requires that an inventor teach the *best mode* of practicing

his invention so as to add to the store of knowledge.[3] But, 35 U. S. C. 112 is not, and never was, intended to act as a limitation on the true scope of the invention. The true scope of the invention is to be determined by the claims (or counts), as the law plainly states (supra, at p. 16).

Petitioner therefore asks the Supreme Court to grant certiorari in this case and to state once and for all the correct version of the law along the lines found in *In re Risse; i.e.*, that a patent claim or the count of an interference is to be read literally for what it can teach to one skilled in the art.

## CONCLUSION.

The petition for writ of certiorari should be granted so that this Court may resolve the two points of uncertainty in the law, as detailed herein.

Respectfully submitted,

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3. See 35 U. S. C. 112 which reads in pertinent part as follows: "The specification shall contain a written description of the invention, and of the manner and process of making and using it—as to enable any person skilled in the art—to make and use the same, and shall set forth the best mode—of carrying out the invention."

# APPENDIX A.

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COURT OF APPEALS, SIXTH CIRCUIT.

H. K. PORTER COMPANY, INC. v. THE GOODYEAR TIRE & RUBBER COMPANY

No. 19911 Decided Jan. 27, 1971

Before Phillips, Chief Judge, and Weick and McCree, Circuit Judges.

McCree, Circuit Judge.

The Goodyear Tire and Rubber Company appeals from a judgment declaring valid and infringed certain patents for the manufacture of "Flexible Hose," a product designed as a replacement for factory-installed original equipment automobile radiator hose.

On August 21, 1962, United States Patent No. 3,050,087 was granted to David M. Caplan as inventor of "Flexible Hose," and three years later, on July 13, 1965, Patent No. 3,194,705 was granted to him as inventor of a method and apparatus for manufacturing this flexible mold-formed radiator hose. Five months later, H. K. Porter Company, the current owner of both patents, brought this action against Goodyear, charging infringement of both the '087 and '705 patents. Goodyear denied infringement and attacked the validity of the patents. After an extensive trial, the District Court held the patents valid and infringed, and granted declaratory and other injunctive relief. We affirm.

Replacement radiator hoses play an important role in the automobile repair field. Original equipment hoses often fail because of internal pressure, vacuum collapse, the corrosive effect of radiator additives on rubber tubing and other causes. These hoses are designed to the specifications of a particular make and model of automobile. Replacement hoses, on the other hand, to be commercially successful, must be capable of substantial standardization. They must not only be able to resist bursting under pressure and to avoid vacuum collapse, but they must also resist bending collapse when they are contorted to permit their being fitted into the varying distances between the engine blocks and radiators of different manufacturers' cars. These technical challenges stimulated intensive inventive activity, some of which gave rise to this litigation.

Considerations of flexibility mandated the use of a material possessing this characteristic of rubber and having sufficient strength to resist bursting under pressure and resistance to the corrosive effect of radiator additives. Also, rigidity is necessary to avoid vacuum collapse, and this requirement presented a difficult problem. In original equipment radiator hoses, an internal spring is commonly used to impart this property. However, original equipment hoses are of uniform length and need not possess the flexibility for adjustment of length as must replacement hoses. Accordingly, the internal spring device was found unacceptable and an external helical reinforcing wire coil spring was considered to give the desired rigidity without preventing flexibility. The precise problem concerned finding a commercially feasible method of incorporating this coil spring appropriately into the rubberoid body of the hose.

Caplan testified that he accomplished this in the following manner:

A. What we have here is a radiator hose formed of its component parts—I should say simultaneously formed and cured of its component parts, and has a section that is interiorly and exteriorly convoluted, that has a reinforcement embedded in the apex of those convolutions, and the only covering over that reinforcement is part of the same material which was used to form the body of the tube.

Q. Is that what you consider to be your invention?

A. Well, I'm not great shakes on these statements, but all I know is that I took something that wasn't there and made it and it was a success in the field and made a great difference in the industry. I think it was invention.

Goodyear, which produced a similar product, challenges the validity of the patents in suit on three grounds: prior invention and disclosure; anticipation by the prior art; and obviousness. It also asserts as a defense against the infringement claim the doctrine of file wrapper estoppel. We consider each of these grounds separately, and conclude that the patents are valid and that they have been infringed.

*Prior invention and disclosure.* Goodyear claims that one Robert E. Roberts invented the same process before Caplan, and that he disclosed this invention to Caplan and to plaintiff's predecessor in interest, the Voit Rubber Company, in 1950 and 1951. Here, the issue of disclosure presents a question of fact, because evidence was introduced in support of the contentions of both parties. The District Court resolved the factual conflict against Goodyear, and its findings are not clearly erroneous. Rule 52(a), Fed. R. Civ. P.

[1] Goodyear's claim of prior invention rests primarily on Roberts' victory over Caplan in Patent Interference No. 91,640. This proceeding concerned an alleged conflict be-

tween Roberts' Patent No. 2,936,812 and claims 1 through 4 of Caplan's '705 patent. The Roberts patent prevailed, and the Caplan '705 application was therefore modified and, as modified, was the basis of the patent issued by the Patent Office. That agency specifically took notice of the interference proceeding, and held that Caplan's patent was valid nevertheless. The decisions of the Patent Office, of course, enjoy a strong presumption of validity under 35 U. S. C. § 282. Simplicity Mfg. Co. v. Quick Mfg., Inc., 355 F. 2d 1012, 1014, 148 USPQ 243, 244 (6th Cir. 1966). Here the District Court found that all of the elements of the challenged claims of the '705 patent were not found in the Roberts '812 patent, or in any other single one of the five prior patents relied on by Goodyear, and this finding is supported by evidence in the record. Any conflict between the language of claim 16 of the '812 patent and the '705 patent assumes significance only if the invention disclosed by the language, drawings, and specifications of the '812 patent conflicts with the invention claimed and disclosed in the '705 patent. See e.g., FMC Corp. v. F. E. Myers & Bros. Co., 384 F. 2d 4, 13, 155 USPQ 299, 305-306 (6th Cir. 1967). Here the District Court found, and we agree, that there was no such conflict.

*Anticipation by prior art.* Goodyear's claim of anticipation by prior art also rests primarily on Interference No. 91,640. It argues that claims involved in an interference are prior art against the loser of the interference. In re Risse, 378 F. 2d 948, 956, 154 USPQ 1, 7-8 (CCPA 1967). But that proposition misses the point raised by plaintiff; that its invention, as ultimately patented, is inventively different from the Roberts '812 patent.

The facts, as found by the District Court, support plaintiff's contention. It found that the Roberts hose is preformed and hand-corrugated on a mandrel and then placed

in a mold for curing and vulcanization. This process may be referred to as mold-curing. The Caplan hose, on the other hand, is mold-formed by putting the separate components in a mold, in which they are molded and vulcanized in the same operation. These findings are supported by evidence in the record and are not clearly erroneous.

Appellant contends that the clearly erroneous standard for reviewing findings of fact, mandated by Rule 52(a), Fed. R. Civ. P., is inapplicable with reference to findings based solely on documentary evidence. The law in this Circuit is well settled to the contrary. United States Steel Corp. v. Fuhrman, 407 F. 2d 1143, 1145-46 (6th Cir. 1969); Commissioner v. Spermacet Whaling & Shipping Co., S/A, 281 F. 2d 646 (6th Cir. 1960).

[2] *Obviousness.* Under 35 U. S. C. § 103, a patent cannot be held valid if the subject matter, although different from the prior art, is such that it would have been obvious to a person of ordinary skill. Goodyear, again relying on the Roberts '812 patent, contends that Caplan's invention is obvious under the test established in Graham v. John Deere Co., 383 U. S. 1, 148 USPQ 459 (1966). In that case the Supreme Court described the inquiries required by § 103:

> Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surround-

> ing the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy.

383 U. S. at 17-18, 148 USPQ at 467.

In the case at bar, the factual findings required by § 103 were made by the District Court. Then the Court concluded:

> 58. The Court finds that the Caplan inventions, as exemplified in the '087 and '705 patents, would not have been obvious to a man skilled in the radiator hose art in 1953 to 1954. The combination of these isolated features of the prior art and original additions thereto, which produced the '087 and '705 patents, would not have been obvious to one skilled in the radiator hose art. In this connection, it is relevant that the Caplan inventions enjoyed immediate and substantial commercial success. They increased the production rate of flexible radiator hoses significantly. Upon introduction into the market, they immediately began to replace the prior hand-built corded fabric hoses. Indeed, the defendant itself was a substantial customer of the Caplan hoses. Prior to the Caplan inventions, the defendant and many others made long and unsuccessful efforts to develop hoses of their own. The existing flexible rubber hoses were unsatisfactory, were expensive, and difficult to produce. There was a long-felt need for an improved and economical flexible radiator hose, and many individuals have attempted to produce one over an extensive period of time. The evidence of a long-felt need and substantial efforts by many individuals to produce an improved flexible radiator hose gives weight to the Court's inference and conclusion that the Caplan inventions would not have been obvious to a person skilled in the flexible radiator hose art in 1953 and 1954. Rather, the Court has concluded that the Caplan inventions were novel, creative, and inventive and were, indeed, surprising to those skilled in the art at the time they were developed.

This conclusion is supported by the facts found and is correct under applicable law.

*File wrapper estoppel.* Goodyear argues that the doctrine of file wrapper estoppel prevents H. K. Porter from objecting to Goodyear's product, because it incorporates features which were abandoned by Caplan in the process of and for the purpose of obtaining a patent from the Patent Office. See Kaiser Industries Corp. v. McLouth Steel Corp., 400 F. 2d 36, 158 USPQ 565 (6th Cir. 1968). Specifically, Goodyear claims that the Caplan patents are limited to "all-rubber" or "single layer" hoses. This contention is without merit. As the District Court found, neither Caplan patent is so limited, and the knit fabric reinforcement employed by Goodyear on its hose is not inventively distinguishable from that patented by Caplan. The District Court also rejected Goodyear's contentions that its wire-reinforcement differed from that in plaintiff's hose and that its hose does not radially expand during the mold-forming process as plaintiff's hose does.

Goodyear does not strenuously argue that there was no infringement if the patent is held valid. We agree with the District Court's findings of fact and conclusions of law, and we affirm that court's decision that the patents in question are valid and have been infringed. The judgment of the District Court is affirmed, and the cause remanded to the District Court for such further proceedings as may be necessary.

Affirmed and remanded.

## APPENDIX B.

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IN THE UNITED STATES COURT

Northern District of Ohio

Eastern Division

* * * (Caption—No. C 65-752). * *

Lambros, District Judge

I. Findings of Fact

*1. This is an action for infringement of United States Patent No. 3,050,087. This patent granted August 21, 1962, to one David M. Caplan, as inventor, related to a flexible rubber hose. The application for this patent was filed March 22, 1957, as a continuation of an earlier application filed February 1, 1954. The complaint also charges infringement of United States Letters Patent No. 3,194,705, granted July 13, 1965, also to David M. Caplan and relating to the "Method and Apparatus for Making Reinforced Corrugated Hose." The application for this patent was filed March 8, 1957, as a division of an earlier application filed February 1, 1954.

2. Plaintiff, H. K. Porter Company, Inc. (Porter) is the owner, by assignments, of the '087 and '705 patents. Defendant Goodyear Tire & Rubber Company (Goodyear), is an Ohio corporation, having a regular and established place of business located in Akron, Ohio, within the Eastern Division of the Northern District of Ohio.

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*The District Court's Findings and Conclusions were not numbered. Numbers have been inserted by defendant-appellant for ease of reference in the briefs.

3. This Court has jurisdiction as to the parties to, and the subject matter of, this action under the patent laws of the United States, Title 35, U. S. C. A., §§ 271, 282, 283, 284, 285, and Title 28, U. S. C. A., §§ 1338(a) and 1400(b).

4. The '087 patent claims as flexible mold-formed hose used as replacement hose on the radiators of automotive vehicles. The flexible molded radiator hose disclosed in this patent has two generally cylindrical ends. The hose itself is corrugated. The body of the hose is composed primarily of rubber or like material, and a helical reinforcing wire coil spring is embedded in the rubber body. This spring has its turns positioned in and secured to the crests of the helical corrugations of the rubber body. The wire coil has a portion of its outer surface disposed contiguous to the outer surface of the crests of the rubber body and completely surrounded by a portion of the rubber body. The ends of the coil spring extend to the ends of the hose, which are covered by fabric sleeves.

5. The construction of this hose, as disclosed in the '087 patent, is such that the hose may be readily bent to conform to the available space adjacent the radiator of an automobile. Also by reason of its construction, the hose is resistant to bursting pressures and to both bending collapse and vacuum collapse.

6. Of the nine claims of the '087 patent, plaintiff relied at the trial only on claims 1 and 2. They are as follows:

*Claim 1.*

"1. A mold-formed flexible hose comprising an interiorly and exteriorly corrugated tubular body molded from thermosetting plastic material, the exterior corrugations being defined by ridges and intervening valleys, the crests of said ridges, in cross-section axially of said hose, having a continuous, smooth, arcuate, mold-formed outer surface free of protuberances and

added material, and wire-like reinforcing means encircling said body and secured to said ridges at the crests thereof, said reinforcing means having a portion of its outer surface substantially immediately contiguous the outer surface of said crests and being completely surrounded by thermoset plastic material, the thickness of said material radially outwardly of said reinforcing means being less than the thickness thereof radially inwardly of said reinforcing means."

*Claim 2.*

"2. A flexible hose as set forth in Claim 1 in which said ridges are helical and said reinforcing means is a helical coil of wire."

7. The '705 patent relates to a method for forming a finished, unitary, flexible molded corrugated wire-reinforced rubber hose, such as is disclosed in the '087 patent in a single mold-forming operation.

8. A typical procedure which may be followed in forming the flexible molded corrugated wire-reinforced rubber hose by the method disclosed in the '705 patent is set forth in the illustrative chart (PX 32), prepared by plaintiff's expert, Dean Fischer (TR 443-444).

9. Of the seventeen claims of the '705 patent, plaintiff relied at the trial upon method claims 1, 2, 3, 5, 6, 13, 14, 15 and 16. Plaintiff relied more specifically upon claims 1, 3 and 14 as representative of this group of claims:

*Claim 1.*

"1. A method of fabricating a hose of thermosetting plastic material with circumferential turns of wire reinforcement means embedded therein, characterized by the use of a hollow mold with a helically corrugated interior circumferential wall and including the steps of: placing a tube of thermosetting plastic material

in said mold with said wire reinforcement means surrounding the tube in the mold and free of engagement with said tube at portions corresponding to the helically corrugated interior wall of said mold; sealing off the interior of the tube from the interior of the mold; introducing fluid under pressure into said tube for the purposes of providing pressure to expand the tube radially; supplying heat to said tube to cause material of the expanded tube to flow around the turns of said reinforcement means into contact with the surrounding mold walls to assume the configuration of the mold; and supplying heat to cure the plastic material of the expanded tube."

*Claim 3.*

"3. A method of fabricating a helically corrugated hose of thermosetting plastic material with circumferential turns of wire reinforcement means embedded therein, said method being characterized by the use of a hollow mold with a helically corrugated interior circumferential wall and including the steps of: placing a tube of thermosetting plastic material inside the turns of said wire reinforcement means; placing the assembly of tube and wire reinforcement means in said mold with the internal surface of said turns of wire in radially spaced relation to the external surface of said tube and with the turns of said wire reinforcement means freely disposed within the helical corrugations of said mold; and with the interior of the tube sealed off from the interior of the mold, introducing fluid under pressure into said tube and also applying heat to said tube for the purposes of, first, expanding the tube radially outward thereby causing the plastic material to engage and flow around the turns of the reinforcement means to embed the reinforcement means, second, forming the assembly to the configuration of the interior of the mold, and third, at least partially curing the plastic material in the expanded configuration."

*Claim 14.*

"14. A method for the manufacture of reinforced helically corrugated hose which comprises placing in a hollow internally corrugated mold the components of said hose before said components are formed into a hose, said components comprising a tubular member of elastomeric material, and a reinforcing member having axially spaced turns whose interior diameter is greater than the exterior diameter of said tubular member, said reinforcing member being disposed in said mold surrounding said tubular member with the axially spaced turns of said reinforcing member in alignment with and freely positioned within the valleys of the corrugations of said mold in radially spaced relation to said tubular member, and uniting and forming said components into a hose, by subjecting said tubular member to internal pressure accompanied by heating to cause it to expand and soften and conform to the shape of said mold while simultaneously flowing around and embedding said turns therein and to at least partially set the material of said tubular member."

11. David M. Caplan is the patentee of the '087 and '705 patents. In January, 1951, he entered the employ of the W. J. Voit Company in California. Voit was at that time manufacturing and selling a so-called corded flexible radiator hose. This was a thin-walled, fabric-covered hose made largely by hand operations.

12. In the manufacture of the corded flexible radiator hose, a tube of rubber is placed on an inflatable mandrel and a closed coil wire spring is positioned over the rubber tube. The wire spring is manually spaced along the rubber tube. The building mandrel is then inflated, expanding the rubber tube and holding it tightly against the wire spring. The entire hose assembly is then cemented and an end strip is placed at each end of the hose assembly to form the built-

up ends of the finished hose. A fabric cover is then hand-wound over the entire length of the rubber tube and wire spring to form the outer cover of the hose. With the fabric cover in place, the components of the hose are then solidified by a stitching operation in which an elastic band is hand-wrapped around the entire hose assembly to eliminate any entrapped air and to form the components into a compact hose assembly. The building mandrel is then deflated and the stitching band removed.

13. The hose assembly is then transferred to a "cording" mandrel. The hose assembly is positioned on the cording mandrel and encased in a so-called "wet wrap" by manually wrapping a wet strip of nylon or cotton fabric. After the "wet wrap" is in place, a length of regular sash cord is tightly hand-wound around the hose assembly between the spring coils. It is necessary to apply substantial pressure in the cording operation, since the "cording," in effect, formed the hose convolutions by depressing the body of the hose assembly between the coils of the wire spring. The cording operation also resulted in some decrease in the length of the hose.

14. With the cord tightly in place, the entire hose assembly, while still on the cording mandrel, is placed in a steam vulcanizer and subjected to a steam atmosphere for a period of from 30 to 55 minutes, with an average time of about 45 minutes being required in the vulcanizer. Upon completion of the vulcanizing operation the sash cord is manually removed from the outside of the cured hose. Thereafter, the wet-wrap is manually removed and the cured hose is stripped from the cording mandrel.

15. This type of hose (and the process by which it was manufactured) presented a number of problems. The amount of convoluting and its attendant decreasing in the length of the hose in the cording operation varied from operator to operator and from day to day so that the com-

pleted hoses were not uniform in length or appearance. In addition, the corded radiator hose readily lost adhesion between the outer fabric cover and the inner tube. This resulted in failure of the hose in use, since the loss of adhesion between the outer fabric cover and the inner tube stock would cause the wire coil spring to cut through the tube. Furthermore, the manufacture of the corded hose was essentially a manual operation. It was slow, laborious and uneconomical. There was a demand for a better hose for the automotive radiator hose replacement trade and for a more efficient and more economical method of making such a flexible replacement hose.

16. Because of the problems experienced by his employer, Voit, with its hand-built corded flexible radiator hoses, and the demand which existed in the trade for a better flexible radiator replacement hose, Caplan undertook in the period 1952-1953 to improve upon the prior art, and to develop a new and better hose than the hand-built corded hose. In the course of this development work, Caplan conceived the idea of an entirely mold-formed hose in which the components of the hose, including a rubber tube and an open-coil wire reinforcing spring, are separately assembled and placed in a convoluted mold and are formed in the convoluted mold into a completed, unitary flexible hose in a single mold-forming operation.

17. Following this development work, Caplan interested his employer, Voit, in the manufacture of his flexible mold-formed radiator hose. Voit set up facilities for the commercial production of Caplan's mold-formed radiator hose. Initially a pilot plant operation was set up in Los Angeles, California. Specimens of the Caplan flexible molded radiator hose, made by this pilot plant, were subjected to field testing in which they performed very satisfactorily.

18. Sometime late in 1954 Voit set up commercial opera-

tions for making the Caplan hose in Danville, Illinois; and early in 1955, Voit started to sell the Caplan hose. The Caplan hose quickly began to replace the hand-built corded flexible radiator hose.

19. Sometime in late 1956 Voit sold its business of manufacturing the Caplan hose, including its plant at Danville, Illinois, and the molds and other equipment therein, to the Thermoid Company. Subsequently, the plaintiff acquired Thermoid, including the Danville plant, and continued thereafter to manufacture and sell the Caplan mold-formed flexible radiator hose. While remaining an employee of Voit, Caplan continued his connection with the Danville plant under Thermoid ownership until sometime in 1958 during which time he provided technical assistance to Thermoid employees in the manufacture of the Caplan hose.

20. After Thermoid acquired the Danville plant of Voit, it discontinued the manufacture of the hand-built corded flexible radiator hose which it had previously manufactured and sold, and converted its entire commercial production of automotive radiator hoses at its Danville plant to the Caplan hose. Since 1957 the corded fabric radiator hose has no longer been commercially made or sold by the plaintiff or by the defendant.

21. The Caplan mold-formed flexible radiator hose manufactured by the Voit Company at its Danville plant, the hose as manufactured by Thermoid (and later by the plaintiff) at its Danville plant in the period 1957-1960, and the hose manufactured and sold by plaintiff since 1960 all embody the construction defined in claims 1 and 2 of the '087 patent and were made by the method of the '705 patent (as defined in claims 1, 3 and 14 thereof).

22. During the period from approximately 1952 to 1956, inclusive, Thermoid sold to the defendant hand-built, corded flexible radiator hose. After Thermoid acquired the Dan-

ville plant from Voit, Thermoid manufactured and sold to the defendant its mold-formed radiator hose. After the plaintiff acquired the Danville plant from Thermoid, plaintiff continued to manufacture and sell mold-formed radiator hose to the defendant until some time in the year 1965.

23. During the years 1957 to 1965, inclusive, the plaintiff and its predecessor, Thermoid, manufactured and sold flexible mold-formed radiator hose in substantial quantities to the defendant and others.

24. In the first quarter of 1960 the plaintiff began to manufacture and sale of a flexible mold-formed radiator hose embodying a longitudinally-extending cord reinforcement. Since then, plaintiff has continued to manufacture and sell such cord-reinforced flexible mold-formed radiator hose. The addition of the longitudinal cord-reinforcement to the all-rubber mold-formed flexible radiator hose previously manufactured and sold by the plaintiff, as exemplified by PX 22, did not change in any way the method employed by the plaintiff at its Danville, Illinois plant in mold-forming its flexible radiator hoses. The methods employed by the plaintiff in making both types of hoses were substantially the same, except for the preliminary step of incorporating cord-reinforcement in the "green hose."

25. The substantial sales of the all-rubber flexible mold-formed radiator hose and of the cord-reinforced flexible mold-formed radiator hose establish that both of these hoses were commercially successful and were acceptable and usable automotive radiator replacement hoses.

26. The plaintiff gave actual notice in writing to the defendant as to the '087 patent on or about May 27, 1965, and the plaintiff notified the defendant as to the issuance of the '705 patent on or about August 26, 1965. Plaintiff gave further notice to the defendant as to the '705 patent by the filing of the complaint herein in November, 1965.

27. The plaintiff began marking its flexible molded radiator hose with the number of patent No. 3,050,087 sometime in the fall of 1962. This was done by incorporating the number of patent No. 3,050,087 in the molds employed in making plaintiff's hose.

28. Sometime in September, 1965, the plaintiff began marking its flexible molded radiator hose with the number of patent No. 3,194,705; and the plaintiff continued thereafter at all times material hereto to mark its flexible molded radiator hose with the number of patent No. 3,194,705.

29. The defendant's hose is formed from a so-called "green hose." This consists of an all-thermoplastic inner tube over which a loose fabric knit is applied. These two components are covered with a thermoplastic tubular layer to form the complete so-called "green hose."

30. The only difference between the construction of the defendant's flexible mold-formed radiator hose and the flexible mold-formed radiator hose disclosed in the '087 patent relates to the incorporation in defendant's flexible mold-formed radiator hose of the knit fabric reinforcement. This knit reinforcement increases the strength of the defendant's hose and its resistance to bursting pressures when used in the radiator system of an automotive vehicle. It does not in any substantial or significant way change the function, mode of operation or manner of use of the defendant's flexible mold-formed radiator hose as compared to the flexible mold-formed hose disclosed in the '087 patent, and as defined in claims 1 and 2 of the '087 patent.

31. Defendant contends that its flexible radiator hose does not come within the scope of claims 1 and 2 of the '087 patent because the wire reinforcement of defendant's hose is "embedded" in the hose convolutions, whereas the language of claim 1 of the '087 patent calls for the wire to be "secured to" the ridges of the hose at the crests. How-

ever, an inspection of defendant's hoses reveals that the spring coils in defendant's hose are located in the crests of the hose, with portions of the spring coils contiguous to the outer surface of the crests and completely surrounded by the thermoset plastic material of the "green hose." They are, therefore, "secured to" the ridges of the hose in the crests thereof, in the same sense and to the same extent as is recited in claim 1 of the '087 patent.

32. Defendant also contends that, in its method of making its mold-formed flexible radiator hose, the wire coil reinforcing spring does not have the degree of radial spacing or freedom from engagement with the "green hose" as is disclosed between the spring and the green tube in the illustrative drawings of the '705 patent. However, the evidence, including the testimony of plaintiff's expert, Dean Fischer, shows that in defendant's method of making its flexible mold-formed radiator hose there is sufficient radial spacing or freedom of engagement between the wire coil reinforcing spring and the "green hose" to enable the coils of the wire-reinforcing spring to be adjusted longitudinally along the "green hose" so that the spring coils can be properly positioned in the valleys of the mold corrugations.

33. Claims 1, 3 and 14 of the '705 patent do not recite the *degree* of radial spacing or freedom of engagement between the green hose or rubber tube and the wire-reinforcing spring. The only requirement of the '705 patent (as construed in the light of the specification and drawings thereof) is that there be sufficient freedom between the "green hose" and the coils of the wire coil reinforcing spring to enable the wire coil reinforcing spring to be readily adjusted along the "green hose" so as to properly distribute the spring coils in the valleys of the mold corrugations, thus insuring that there is only one coil seated in each

mold convolution. This is necessary to avoid wires crossing the mold convolutions, thereby producing a defective hose.

34. Defendant also contends that there is no radial expansion of its "green hose" during the process of forming its hose. However, a visual comparison of defendant's "green hose," as it appears before the mold-forming operation, with the defendant's finished hose, as it appears after the mold-forming operation, reveals that radial expansion has, in fact, occurred in the process of making defendant's hose, and particularly in those portions of the "green hose" which correspond to the crests of the finished hose.

35. In this connection, the Court notes that the manufacturing tolerances for the defendant's "green hose," as contained in its specifications for an acceptable "green hose," provide for a "green hose" having an external diameter which can be *smaller* than the minimum internal diameter of defendant's mold. Also, the external diameter of defendant's "green hose," according to its specifications, is *always* smaller than the maximum internal diameter of defendant's mold.

36. Defendant also contends that the inclusion of the knit reinforcement in its "green hose" distinguishes its process for forming flexible radiator hoses from the process defined by claims 1, 3 and 14 of the '705 patent. This contention by defendant is without merit, since the only requirement of the disclosure and claims of the Caplan '705 patent is that the "green hose" be formed principally or chiefly of rubber or similar thermoplastic material, so that, during the mold-forming process, at least a portion of the thermoplastic material of the "green hose" will soften and flow sufficiently to cover the reinforcing spring and conform to the shape of the convoluted mold. This teaching of the Caplan patent is followed in defendant's process.

37. The Court has concluded that the defendant's flexible hose was developed with full knowledge of the plaintiff's flexible hose and of the patents underlying it. Furthermore, the Court has concluded that the defendant attempted to duplicate the plaintiff's flexible hose both in method, structure, and performance without infringing upon the plaintiff's patents. The record is replete with evidence supporting these findings. Indeed, the evidence indicates that the defendant's development process became progressively more similar to the plaintiff's patented method and structure. Statements and correspondence of the defendant's own agents indicate, that the defendant's accused article and method is patterned after the plaintiff's patented article and method.

38. The defendant, at the trial, attempted to demonstrate that Mr. Caplan was not the original inventor of the matter disclosed in the '087 and '705 patents. Defendant asserted that one Robert E. Roberts developed this knowledge sometime in 1950 or 1951, and that he disclosed it to Caplan and a number of other Voit employees. It is the Court's conclusion that the evidence does not support this position. The Court finds that Caplan had no knowledge of any of Roberts' developments at the time he discovered the information underlying the '087 and '705 patents. Rather, the Court finds that Caplan made these developments and discoveries on his own and without the benefit of any knowledge referrable to Robert E. Roberts. Caplan's work was entirely independent of Roberts and did not rely upon Roberts in any significant way.

39. At the trial the defendant relied upon the following patents in support of its defenses (under Title 35, U. S. C. A., §§ 102 and 103) to claims 1 and 2 of the '087 patent:

| Patent No. | Patentee | Title | Date |
|---|---|---|---|
| 314,400 | Eames | Hose or Tubing | March 24, 1885 |
| 375,877 | Judson | Rubber Hose | January 3, 1888 |
| 2,248,898 | Ross | Method of Making Rubber Articles | July 8, 1941 |
| 2,272,704 | Harding | Method and Apparatus for Making Corrugated Tubes | February 10, 1942 |
| 2,396,059 | F. T. Roberts | Flexible Tube | March 5, 1946 |
| 2,570,259 | McKinley | Method of and Apparatus for the Manufacture of Flexible Conduits | October 9, 1951 |
| 2,936,812 | R. E. Roberts | Method and Apparatus for Making Flexible Corrugated Reinforced Hose | May 17, 1960 |
| 227,373 (British) | Kort | Improvements Relating to the Manufacture of Hose Pipes of Rubber or the Like | January 15, 1925 (Complete Accepted) (Printed, 1925) |

40. At the trial the defendant relied upon the following patents in support of its defenses (under Title 35, U. S. C. A., §§ 102 and 103) to the claims of the '705 patent:

| Patent No. | Patentee | Title | Date |
|---|---|---|---|
| 314,400 | Eames | Hose or Tubing | March 24, 1885 |
| 375,877 | Judson | Rubber Hose | January 3, 1888 |
| 2,248,898 | Ross | Method of Making Rubber Articles | July 8, 1941 |
| 2,272,704 | Harding | Method and Apparauts for Making Corrugated Tubes | February 10, 1942 |
| 2,300,441 | Voit | Method of Making Athletic Balls | November 3, 1942 |
| 2,936,812 | R. E. Roberts | Method and Apparatus for Making Flexible Corrugated Reinforced Hose | May 17, 1960 |
| 227,373 (British) | Kort | Improvements Relating to the Manufacture of Hose Pipes of Rubber or the Like | January 15, 1925 (Complete Accepted) (Printed, 1925) |

41. The Eames patent (No. 314,440, issued March 24, 1885) discloses a railroad vacuum brake hose. As shown in the patent drawings, all of the material of the Eames hose is outside of the reinforcement wire and the wire is not located within the body of the hose material. This arrangement of hose components is unsuitable for a hose under

positive fluid pressure since such pressure would cause the hose wall material to separate from the wire. Furthermore, Eames taught the art to *avoid* the use of hose in which the wire is "entirely embedded" in the hose material. Eames, we note, recognized the equivalence between all-rubber and composite (fabric and rubber) hose materials in the rubber hose art.

42. The Judson patent (No. 375,877, issued January 3, 1888) discloses a railway *pressure* brake hose. The Judson hose is externally, but not internally, corrugated. This makes the Judson hose relatively stiff and inflexible and thus unsuitable as an automotive radiator replacement hose. An essential teaching of Judson is that layers of canvas or other equivalent heavy fabric should be placed both outside and inside the reinforcement wire. Judson's wire is "entirely embedded" in the material of the hose wall.

43. The Ross patent (No. 2,248,898, issued July 8, 1941) discloses and claims a process of making gas mask tubes from inelastic gels which are capable of plastic flow in the wet gel state under stress. No wire reinforcement for the tubes is disclosed or suggested in Ross. Only low pressure air, but not steam or hot air, is used during the expansion step in the mold of Ross. After the expansion step in the mold, Ross removes water from the gel by synaeresis prior to the vulcanization or curing step. The Ross patent was specifically considered by the Patent Office in connection with the application for the Caplan '705 patent.

44. The Harding patent (No. 2,272,704, issued February 10, 1942) disclosed and claimed a method and apparatus for making corrugated rubber tubes. The Harding process involves shaping or forming the corrugated tube on a corrugated mandrel prior to curing the preformed tube in a vulcanizing chamber, instead of using a mold. No wire

reinforcement for the corrugated tube is disclosed or suggested anywhere in Harding.

45. The Voit patent (No. 2,300,441, issued November 3, 1942) discloses and claims a multi-step method of making athletic balls, such as basketballs, utilizing a plurality of separate forming and vulcanizing steps. The balls disclosed by Voit have no corrugations, externally or internally, and contain cord, yarn, or thread reinforcement rather than any metallic wire reinforcement. The Voit balls are always provided with wear-resistant covers after they are cured in molds.

46. The Roberts patent (No. 2,396,059, issued March 5, 1946) discloses a flexible gas mask tube, the corrugations of which are formed by a cording or hand-wrapping step prior to a separate vulcanizing step. The utility of the hoses of this patent relates to applications requiring tubing which can be readily stretched lengthwise, such as in oxygen helmets and anesthetizing apparatus. The closed coil spring used in making the Roberts tube is engaged to the inner tube by tape and/or cement and is under considerable tension in the end product. An outer fabric cover, or stockinet, is used in making the Roberts gas mask tube. The thickness of the tube material radially outward of the wire reinforcement is substantially the same as the thickness thereof radially inward of the wire. The Roberts '059 patent was specifically considered by the Patent Office in connection with the application for the Caplan '087 patent.

47. The McKinley patent (No. 2,570,259, issued October 9, 1951) discloses and claims a method and apparatus for making flexible vacuum cleaner hose. McKinley's conduit is not mold-formed, but an outer wire helix is used for cording down the hose between its reinforcement wire coils to form the external corrugations in the hose prior to the

vulcanizing or curing step. The inner surface of the finished McKinley hose is "completely smooth" and uncorrugated. This McKinley patent was specifically considered by the Patent Office in connection with the application for the Caplan '087 patent (PX 3, page 43).

48. The Roberts Patent No. 2,936,812 was issued on a continuation-in-part application, filed September 3, 1957, of the Roberts parent application, filed May 21, 1954. The Roberts parent application was filed three months later than the Caplan parent application, which was filed February 1, 1954. Claims 16 to 19, inclusive, of Roberts '812 were added for the first time when the Roberts continuation-in-part application was filed in 1957.

49. Roberts patent '812, issued May 17, 1960, discloses and claims a method and apparatus for making flexible corrugated wire-reinforced hose. Roberts discloses only one method of making the several constructions of his hose. In the Roberts method, the hose corrugations are formed on an inflatable, convoluted forming mandrel in a separate "forming" or cording step, prior to "setting," i.e., vulcanizing or curing, the already "formed" hose in a mold. Claims 16 to 19, inclusive, of Roberts '812 define in broad terms the method disclosed by Roberts in his specification of making his hose construction with the wire reinforcement in the crests of the external corrugations of the hose. In the Roberts method, an inner envelope is placed over the inflatable mandrel and a reinforcing spring placed over the envelope. An outer envelope is positioned over the reinforcing spring to form the hose assembly. The mandrel is inflated into corrugated shape, thereby forming the inner envelope into corrugated shape also. For locating the wires in the troughs of the hose corrugations, the mandrel is inflated after the reinforcing spring has been covered by the outer envelope. For locating the wires in

the crests of the corrugations, the mandrel is inflated prior to the outer cover being applied over the spring and inner envelope. Cement is applied between the inner and outer envelopes and the hose assembly is adhered together in corrugated shape by means of a forming strip wrapped down tightly against the troughs of the corrugations. When the hose assembly is adhered in corrugated form, the forming mandrel is deflated and the corrugated hose assembly removed for curing. This patent was specifically considered by the Patent Office in connection with the application for the '705 patent.

50. The Kort British patent (No. 227,373, accepted January 15, 1925) discloses the formation and vulcanization of a rubber hose. The patent does not disclose or suggest the use of any wire reinforcement in the hose or the formation of any corrugations therein.

51. All of the elements of product claims 1 and 2 of the '087 patent are not found in any single one of the four prior art patents applied against the claims. The Judson hose is not "interiorly . . . corrugated" and the outer surface of the hose is not "free of . . . added material" as recited in claim 1 of the '087 patent. In the Eames hose, all of the material is outside of the wire reinforcement and "the thickness of said material radially outwardly of said reinforcing means" is, therefore, *greater* than, not "less than the thickness thereof radially inwardly of said reinforcing means," as recited in claim 1 of the '087 patent. In the Roberts '059 hose, the thickness of the material radially outward of the reinforcing means is "substantially the same" as the thickness thereof radially inward of said reinforcing means. Also, the Roberts '059 hose is not "mold-formed" but is hand-built and corded-down and the outer surface thereof is not "free of . . . added material," as recited in claim 1 of the '087 patent, since it has an outer fabric cover over the reinforcing spring. The Roberts

'812 hose likewise is not "mold-formed" but is hand-formed in corrugated shape by a manually-applied forming strip. In addition, the outer surface of the Roberts '812 hose is not "free of . . . added material," as recited in claim 1 of '087, since it has an outer cover over the wire reinforcement. In the Roberts '812 hose, the thickness of the hose material radially outward from the wire reinforcement is "substantially the same" as the thickness radially inward.

52. All of the elements of method claims 1, 3 and 14 of the '705 patent are not found in any single one of the five prior art patents relied upon by defendant as against the relevant method claims of the '705 patent, namely, the patents to Eames, Judson, Harding, Voit and Roberts '812.

53. All of the elements of the relevant claims of the '087 and '705 patents or their equivalents are not found in any one single patent relied upon by the defendant where they do substantially the same work in substantially the same way to accomplish the same result. Thus, the inventions of the '087 and '705 patents are not anticipated by the prior art relied upon by defendant.

54. The burden of establishing that the claimed subject matter of the '087 and '705 patents as a whole was obvious to one skilled in the flexible radiator hose art at the time the inventions disclosed and claimed in these patents were made is upon the defendant (35 U. S. C. A., § 282).

55. The Court has concluded that at the time the inventions disclosed and claimed in the patents in suit were made, these developments would not have been obvious to one skilled in the flexible radiator hose art. The Roberts '059 and '812 patents exemplify the prior art of hand-built fabric hoses. The Roberts '812 patent was merely another attempt to improve the prior art of hand-built hoses. Indeed, much of the work being done in this field at the time

of the Caplan inventions is directed towards improvement in the hand-built fabric hose.

56. The Eames and Judson patents were over seventy years old at the time of the Caplan inventions. The age of these patents tends to negate any inference that the Caplan patents were obvious on the basis of these ancient patents.

57. Moreover, the Roberts '812 patent, including claim 16 thereof, was fully considered by the Patent Office in connection with the allowance of the relevant claims of the '705 patent in suit. This adds weight to the presumption of administrative correctness attached to the actions of the Patent Office in issuing the '705 patent and to the validity of the '705 patent itself.

58. The Court finds that the Caplan inventions, as exemplified in the '087 and '705 patents, would not have been obvious to a man skilled in the radiator hose art in 1953 to 1954. The combination of these isolated features of the prior art and original additions thereto, which produced the '087 and '705 patents, would not have been obvious to one skilled in the radiator hose art. In this connection, it is relevant that the Caplan inventions enjoyed immediate and substantial commercial success. They increased the production rate of flexible radiator hoses significantly. Upon introduction into the market, they immediately began to replace the prior hand-built corded fabric hoses. Indeed, the defendant itself was a substantial customer of the Caplan hoses. Prior to the Caplan inventions, the defendant and many others made long and unsuccessful efforts to develop hoses of their own. The existing flexible rubber hoses were unsatisfactory, were expensive, and difficult to produce. There was a long-felt need for an improved and economical flexible radiator hose, and many individuals have attempted to produce one over an exten-

sive period of time. The evidence of a long-felt need and substantial efforts by many individuals to produce an improved flexible radiator hose gives weight to the Court's inference and conclusion that the Caplan inventions would not have been obvious to a person skilled in the flexible radiator hose art in 1953 and 1954. Rather, the Court has concluded that the Caplan inventions were novel, creative, and inventive and were, indeed, surprising to those skilled in the art at the time they were developed.

## II. Conclusions of Law

### A. Validity

1. Claims 1 and 2 of the '087 patent and claims 1, 2, 3, 5, 6, 13, 14, 15 and 16 of the '705 patent carry a statutory presumption of validity arising from their issuance under 35 U. S. C. A., § 282.

2. The burden of establishing invalidity of claims 1 and 2 of the '087 patent and of claims 1, 2, 3, 5, 6, 13, 14, 15 and 16 of the '705 patent rests upon the defendant, and this burden has not been sustained by the evidence. 35 U. S. C. A., § 282; *Mumm* v. *Decker & Sons*, 301 U. S. 168 (1937); *Forestek Plating & Mfg. Co.* v. *Knapp Monarch*, 106 F. 2d 554 (6th Cir. 1939).

3. The presumption of validity attached to the issuance of claims 1, 2, 3, 5, 6, 13, 14, 15 and 16 of the '705 patent is further strengthened by the fact that these claims were allowed by the Patent Office after the Patent Office had fully considered the entire disclosure and claims of the Roberts '812 patent including claim 16 thereof, admittedly the most pertinent prior art reference relied upon by the defendant as to the '705 patent. *Williams Mfg. Co.* v. *United Shoe Machinery Corp.*, 121 F. 2d 273 (6th Cir. 1941).

4. Since all of the elements of claims 1 and 2 of the '087

patent and all of the steps of claims 1, 2, 3, 5, 6, 13, 14, 15 and 16 of the '705 patent could not be found in any one single patent, these claims are not invalid because of anticipation under 35 U. S. C., § 102; *Aluminum Co. of America* v. *Sperry Products, Inc.*, 285 F. 2d 911 (6th Cir. 1960); *Dewey & Almy Chemical Co.* v. *Mimex, Co.*, 124 F. 2d 986 (2d Cir. 1942).

5. Claims 1 and 2 of the '087 patent and claims 1, 2, 3, 5, 6, 13, 14, 15 and 16 of the '705 patent are not invalid, under 35 U. S. C. A., § 102, based upon the prior art relied upon by the defendant as to said claims of the '087 and '705 patents.

6. Claims 1 and 2 of the '087 patent and claims 1, 2, 3, 5, 6, 13, 14, 15 and 16 of the '705 patent are not invalid because of alleged disclosure of the subject matter thereof by Robert E. Roberts or Fred T. Roberts, Sr., to the patentee, David M. Caplan, or to any other employee of the W. J. Voit Company, or because of alleged prior invention by the said Robert E. Roberts or Fred T. Roberts, Sr., of the subject matter of said claims of the '087 and '705 patents.

7. The defense of prior invention must be established by evidence which is clear and convincing. *Barbed Wire Patent Case*, 143 U. S. 275 (1892); *Eibel Process Co.* v. *Minnesota & Ontario Paper Co.*, 261 U. S. 45 (1923); *Smith* v. *Hall*, 301 U. S. 216 (1937); *Cold Metal Products Co.* v. *E. D. Bliss Co.*, 285 F. 2d 244 (6th Cir. 1960); *National Latex Products Co.* v. *Sun Rubber Co.*, 274 F. 2d 224 (6th Cir. 1960).

8. The defendant's defense of alleged prior invention by Robert E. Roberts or Fred T. Roberts, Sr., as to the subject matter of claims 1 and 2 of the '087 patent, and as to the subject matter of claims 1, 2, 3, 5, 6, 13, 14, 15 and 16 of the '705 patent, and the alleged disclosure thereof to the patentee, David M. Caplan, and/or other employees of the W. J. Voit Company, has not been sustained by the evidence.

9. The defendant has failed to sustain any defense under 35 U. S. C. A., § 102, as against the claims of the '087 and '705 patents in suit.

10. Claims 1 and 2 of the '087 patent and claims 1, 2, 3, 5, 6, 13, 14, 15 and 16 of the '705 patent are not invalid under 35 U. S. C. A., § 103, because the differences between the subject matter of said claims and the prior art relied upon by the defendant are such that the claimed subject matter as a whole would have been non-obvious at the time the Caplan inventions were made to a person having ordinary skill in the radiator hose art. 35 U. S. C. A., § 103.

11. The inventions of the '087 and '705 patents enjoyed substantial commercial success; they filled a long-felt need for a better flexible radiator hose for the automotive replacement market; they substantially replaced in the trade the prior replacement radiator hose; and they achieved success in solving problems of long-standing in the prior hose, which solutions had eluded the industry, including the defendant. These factors are relevant in establishing that the claimed subject matter of the claims of the '087 and '705 patents was non-obvious. *Graham* v. *John Deere Co.*, 383 U. S. 1 (1966); *Goodyear Tire & Rubber Co., Inc.* v. *Ray-O-Vac Co.*, 321 U. S. 275 (1944); *Reiner* v. *I. Leon Co.*, 285 F. 2d 501 (2d Cir. 1960); *Mantle Lamp Co. of America* v. *George H. Bowman Co.*, 53 F. 2d 441 (6th Cir. 1931); *Simplicity Mfg. Co.* v. *Quick Mfg., Inc.*, 355 F. 2d 1012 (6th Cir. 1966).

12. The subject matter of claims 1 and 2 of the '087 patent, and of claims 1, 2, 3, 5, 6, 13, 14, 15 and 16 of the '705 patent, was not obvious to a person having ordinary skill in the art of rubber radiator hoses at or prior to the time the inventions of said claims were made by the patentee, Caplan, in or about the period 1953-1954.

13. Claims 1 and 2 of the '087 patent and claims 1, 2, 3, 5, 6, 13, 14, 15 and 16 of the '705 patent are valid.

B. Infringement

14. Claims 1 and 2 of the '087 patent have been infringed by the defendant by its manufacture and sale of defendant's flexible mold-formed radiator hose.

15. Claims 1, 2, 3, 5, 6, 13, 14, 15 and 16 of the '705 patent have been infringed by the defendant's method or process of manufacturing its flexible mold-formed radiator hose in accordance with the method or process disclosed in the plaintiff's illustrative chart (PX 33) and in the Stipulation of December 10, 1966, and letter attachment thereto (PX 6).

16. There is no filewrapper estoppel resulting from any of the proceedings in the Patent Office during the prosecution of the application for the '087 patent, as shown by the filewrapper thereof, or otherwise, which would estop claims 1 and 2 of the '087 patent from being entitled to an interpretation and construction which would include within their scope the knit-reinforced, flexible mold-formed radiator hose manufactured and sold by the defendant.

17. There is likewise no filewrapper estoppel resulting from any of the proceedings in the Patent Office during the prosecution of the application for the '087 patent, as shown by the filewrapper thereof, which would estop claims 1 and 2 of the '087 patent from being properly entitled to an interpretation and construction which would include within their scope the arrangement and positioning of the coils of the wire coil reinforcing spring, as embodied in defendant's knit-reinforced flexible mold-formed radiator hose.

18. Claims 1 and 2 of the '087 patent are not limited to a so-called all-rubber flexible mold-formed radiator hose but are properly entitled to a construction and interpretation which includes within their scope the defendant's knit-reinforced flexible mold-formed radiator hose.

19. There is no filewrapper estoppel resulting from any of the proceedings in the Patent Office during the prosecution of the application for the '705 patent, as shown by the filewrapper thereof, or resulting from any of the proceedings in or during the Roberts v. Caplan Interference No. 91640, which would estop any of claims 1, 2, 3, 5, 6, 13, 14, 15 and 16 of the '705 patent from being properly entitled to an interpretation and construction which would include within their scope the defendant's method or process of manufacturing its knit-reinforced flexible mold-formed radiator hose.

20. Claims 1, 2, 3, 5, 6, 13, 14, 15 and 16 of the '705 patent are not limited to a method or process of making a so-called all-rubber flexible mold-formed radiator hose, as exemplified by PX 18 and 22, but are properly entitled to an interpretation and construction which includes, in all respects, defendant's method or process of making its knit-reinforced flexible mold-formed radiator hose.

21. Claims 1 and 2 of the '087 patent are properly entitled to an interpretation which includes within their scope the so-called all-rubber flexible mold-formed radiator hose made first by Voit and subsequently by Thermoid and plaintiff, as well as plaintiff's present longitudinal cord-reinforced flexible mold-formed radiator hose.

22. Claims 1, 2, 3, 5, 6, 13, 14, 15 and 16 of the '705 patent are properly entitled to an interpretation which includes within their scope the plaintiff's method of making the so-called all-rubber flexible mold-formed radiator hose made by Voit and then by Thermoid and plaintiff, as well as the plaintiff's method of making its present longitudinal cord-reinforced flexible mold-formed radiator hose.

23. Defendant's flexible mold-formed radiator hose comes clearly within the language and scope of claims 1 and 2 of the '087 patent, and defendant's hoses are for the same

purpose and accomplish the same result in the same way and by the same construction as the hoses defined in and by claims 1 and 2 of the '087 patent and infringement of said claims is thus established. *Graver Tank & Mfg. Co.* v. *Linde Air Products Co.*; 339 U. S. 605 (1950); *Great Lakes Equip. Co.* v. *Fluid Systems, Inc.*, 217 F. 2d 613 (6th Cir. 1954).

24. Defendant's method or process for manufacturing its flexible mold-formed radiator hose comes clearly within the language and scope of claims 1, 2, 3, 5, 6, 13, 14, 15 and 16 of the '705 patent; and defendant's method or process is for the same purpose, accomplishes the same result in the same way and by the same steps as the method or process defined in and by claims 1, 2, 3, 5, 6, 13, 14, 15 and 16 of the '705 patent, and infringement of said claims is thus established.

25. Plaintiff has complied with all of the statutory requirements as to marking and notice as to the '087 and '705 patents under 35 U. S. C. A., § 287.

26. Plaintiff is entitled to the relief prayed for in the complaint herein including:

1. An accounting for damages, under the provisions of 35 U. S. C. A., § 284, suffered by the plaintiff by reason of defendant's infringement of claims 1 and 2 of the '087 patent and claims 1, 2, 3, 5, 6, 13, 14, 15 and 16 of the '705 patent.

2. An injunction order permanently enjoining the defendant, its officers, agents, servants, employees, and attorneys, and all those persons in active concert with them who receive actual notice of the injunction order by personal service or otherwise from:

(a) manufacturing, selling or using, or offering for sale, or use, or causing to be manufactured, sold or used, or offered for sale, defendant's flexible, knit-reinforced,

mold-formed radiator hose, as exemplified by PX 9 and by PX 25A and PX 25B, or any flexible radiator hose embodying the construction of claims 1 and 2 of the '087 patent;

(b) manufacturing, selling, or using or offering for sale or use, or causing to be manufactured, sold or used, any flexible radiator hose in infringement of claims 1 and 2 of the '087 patent;

(c) otherwise directly or contributorily infringing claims 1 and 2 of the '087 patent, or either of said claims;

(d) practicing or causing to be practiced the process or method of making knit-reinforced flexible mold-formed radiator hose in accordance with the process or method employed by the defendant in the manufacture of its knit-reinforced flexible radiator hose, as exemplified by PX 9 and PX 25A and PX 25B, by the process or method disclosed in the plaintiff's illustrative chart, PX 33, and in the stipulation of December 10, 1966, and letter attachment thereto, PX 6, or by any process or method covered by claims 1, 2, 3, 4, 5, 6, 13, 14, 15 and 16 of the '705 patent;

(e) manufacturing or causing to be manufactured any flexible radiator hose by a method or process covered by claims 1, 2, 3, 5, 6, 13, 14, 15 and 16 of the '705 patent or any of said claims; and

(f) otherwise directly or contributorily infringing claims 1, 2, 3, 5, 6, 13, 14, 15 and 16 of the '705 patent or any of said claims; and

3. A judgment in accordance herewith.

/s/ THOMAS D. LAMBROS,
*United States District Judge.*

Supreme Court, U.S.
FILED
SEP 14 1971
E. ROBERT SEAVER, CLERK

IN THE

# Supreme Court of the United States

No. 71-103
OCTOBER TERM, 1971

THE GOODYEAR TIRE & RUBBER COMPANY,
*Petitioner,*

*v.*

H. K. PORTER COMPANY, INC.,
*Respondent.*

## RESPONDENT'S BRIEF IN OPPOSITION TO THE PETITION FOR A WRIT OF CERTIORARI

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IN THE

# Supreme Court of the United States

No. 71-103
October Term, 1971

THE GOODYEAR TIRE & RUBBER COMPANY,
*Petitioner,*

*v.*

H. K. PORTER COMPANY, INC.,
*Respondent.*

## RESPONDENT'S BRIEF IN OPPOSITION TO THE PETITION FOR A WRIT OF CERTIORARI

### INTRODUCTORY STATEMENT

The filing of the Petition herein arises solely out of the Petitioner's dissatisfaction with the Findings of Facts and Conclusions of Law which formed the basis of the decision and judgment of the District Court, as affirmed unanimously by the Court of Appeals for the Sixth Circuit [437 F. 2d 244 (1971)]. Pursuant to these decisions, the relevant claims of Respondent's Caplan Patents Nos. 3,050,087 and 3,194,705 (hereinafter '087 and '705) were held valid and infringed.

In its petition, Petitioner merely presents to this Court the same factual and legal arguments which it has already twice urged unsuccessfully below.

The Petition herein should be denied for the reasons that:

(1) There is no conflict of decisions between or among the lower Courts as to either of the two patents in suit, which have not been adjudicated in any other litigation;

(2) The Petition presents no question of federal law;

(3) There is no constitutional issue involved in this litigation;

(4) None of the other reasons suggested in Rule 19 of this Court for the granting of a Writ of Certiorari is present in this case; and

(5) The Petition is untimely.

## COUNTER-STATEMENT OF THE CASE

Petitioner's "Statement of the Case" is an incomplete statement of the essential facts in the action below, coupled with arguments which are without merit and which will be answered hereinafter, and hence the present counter-statement is deemed necessary.

The action below was a conventional action for patent infringement which presented no unusual questions of patent infringement or validity. Respondent's '087 and '705 patents were duly and properly issued by the United States Patent Office and the relevant claims thereof here in issue were sustained as valid and infringed by the District Court (R.App. 8-36)*, whose decision was unanimously affirmed by the Court of Appeals for the Sixth Circuit (R.App. 1-7).

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*All references herein to the Appendix to Respondent's brief are designated "R.App." For convenience, the decisions of the Courts herein below and all statutes and rules cited in this brief are reproduced in said Appendix.

The '087 patent relates to and claims a flexible, mold-formed automotive radiator hose which is especially designed for use as a replacement for factory-installed original radiator hose. The '705 patent discloses and claims a method of manufacturing flexible, mold-formed automotive radiator hose (R.App. 1-2; 9-10). The inventions of these patents have enjoyed substantial commercial success. Prior to the commencement of Petitioner's infringing activities, Respondent made substantial sales of its patented hose, including significant sales thereof to Petitioners (R.App. 6-7). When Petitioner undertook its own production of flexible radiator hoses, its accused hose and method, as the District Court found, were actually "patterned after the plaintiff's [Respondent's] patented article and method" (R.App. 21).

In the Petition, there is no denial of infringement of either the '087 or of the '705 patent, although the defense of non-infringement as to both patents was urged vigorously below.

Likewise, it appears that the Petitioner, in this Court, does not challenge in any respect the validity of the '087 patent since the Petition is entirely silent in regard to the '087 patent and deals exclusively with the issue of the validity of the claims of the '705 patent. The Petitioner does contend that the '087 patent and the '705 patents involve only one inventive concept (P. 6)*, as though to imply that the validity of the '087 patent is, in some mysterious manner not explained, dependent upon the validity of the '705 patent. However, the '087 and '705 patents, and the relevant claims thereof in issue, define

*All references herein to the Petition are designated "P".

separate inventions* and by statute are each presumed to be independently valid.**

In the Courts below, the Petitioner attacked the validity of the claims of the '705 patent in issue upon numerous grounds but, with one exception which will be discussed hereinafter, all of such defenses challenging the validity of the claims of the '705 patent have been abandoned, including the defense of alleged "obviousness" under 35 U.S.C. § 103 (R.App. 37-38).

The sole defense now asserted by the Petitioner as to the validity of the claims of the '705 patent, in issue, relates to the legal effect of a Patent Office interference proceeding, or priority contest, between the then-pending patent application which ultimately matured into the Caplan '705 patent, in suit, and claims 16-19 of a patent which had previously issued to one Robert E. Roberts as Patent No. 2,936,812 (hereinafter the '812 patent). This defense was fully considered by both Courts below and both Courts ruled thereon adversely to the Petitioner (R.App. 3-5; 25-26, 28, 30).

The main count or claim of the interference proceeding in the Patent Office was claim 16 of the '812 patent, which was so broadly worded that it was readable, in words, upon a common aspect of the method disclosed in the Roberts '812 patent and the method disclosed in the then-pending application for the Caplan '705 patent.***

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*The Patent Office found that there were separate inventions involved and required separate applications directed to each of such inventions, pursuant to the provisions of 35 U.S.C. § 121 (R.App. 38). (Ex. Vol. 58-60.) All references to the Exhibit Volume on appeal containing copies of Plaintiff's and Defendant's trial exhibits are designated "Ex. Vol."

**35 U.S.C. § 282 (R.App. 38).

***The common aspect of the mold-curing method disclosed in the '812 patent and the mold-forming method of the then-pending application for the Caplan '705 patent was the use of a mold. This is the only feature that the two methods had in common. Despite this common aspect, the Court of Appeals found the Caplan method, as patented, to be inventively different from the method disclosed by

The application for the Roberts '812 patent was filed *after* Caplan had filed his application. Moreover, claim 16 and the other claims involved in the interference were not added until Roberts filed a continuation-in-part application in 1957 (R.App. 25), after he had already seen the Caplan process of the '705 patent in commercial operation (Ex. Vol. 257-263). Nevertheless, the Roberts '812 patent issued while Caplan's application for the '705 patent was still pending.

Caplan then copied into his application claim 16 and certain other broad claims of the Roberts '812 patent for the purpose of enabling the Patent Office to declare or institute an interference proceeding in order to determine priority of invention as to the subject matter of these broad claims. After the Board of Patent Interferences in the Patent Office had awarded priority of the broad claims or interference counts to Roberts, Caplan cancelled from his application the claims involved in the interference and submitted new claims to the Patent Office directed to the particular, specific method of his own invention for making flexible, **mold-formed** automotive radiator hose. These new claims, directed to Caplan's own specific method for making **mold-formed** automotive radiator hose, were then fully considered by the Patent Office, after the termination of the interference proceeding, and with full knowledge thereof by the Patent Examiner as to the results of the then-terminated interference. After such consideration, these new claims were allowed and the '705 patent here, in suit, was granted to Caplan (R.App. 3-4; 28, 30).

It is these new claims of the '705 patent here, in issue, which were held valid and infringed by both Courts below.

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Roberts (R.App. 5). Rule 205(b) of the Patent Office Rules of Practice, relied upon so heavily by Petitioner, does not require that two disclosures be **identical** or co-extensive in order to interfere, but only that the disclosures have some common aspect upon which the words of the claim or count in interference are readable. (R.App. 37).

## ARGUMENT

### I

### THE BLONDER-TONGUE DECISION OF THIS COURT HAS NO APPLICATION TO THE FACTS IN THE PRESENT CASE

The first question presented by the Petitioner for this Court's review is set forth in the petition as follows (P. 2):

> "Whether the Court of Appeals for the Sixth Circuit, in view of the rule announced by this Court in *Blonder-Tongue Laboratories, Inc.* v. *University of Illinois Foundation et al.*, erred in failing to consider petitioner's plea against respondent as an estoppel based on a prior decision by the Patent Office Board of Patent Interferences, on the same issue presented to the Courts below?"

Petitioner, in its argument in support of its position as to Question One (P. 9-14), erroneously attempts to construe this Court's decision in the case of *Blonder-Tongue Laboratories, Inc.* v. *University of Illinois Foundation et al.* 402 U.S. 313 (1971) as being applicable to the totally different fact situation involved in the present case. Petitioner, in effect, is attempting to have this Court believe that a question of federal law is here involved where none, in fact, exists.

Thus, in *Blonder-Tongue,* the Isbell Patent No. 3,210,767, which related to a radio and television antenna, had been held invalid by the Court of Appeals for the Eighth Circuit but was, nevertheless, subsequently held valid and infringed by the Court of Appeals for the Seventh Circuit. Prior to *Blonder-Tongue,* this Court had held in *Triplett* v. *Lowell,* 297 U.S. 638 (1936) that an adjudication adverse to any or all of the claims of a patent did not

preclude another suit upon the same claims against a different defendant.

This Court's decision in *Blonder-Tongue* modified the *Triplett* decision and enunciated the doctrine that a patentee in patent litigation is estopped from asserting the validity of a patent which had already been held invalid in prior litigation unless the patentee can establish that he did not have a full and fair opportunity to litigate the validity of his patent in the prior action.

In the present case, after the termination of the Roberts-Caplan interference, the claims or counts there involved were cancelled from the then-pending Caplan application for the '705 patent (R.App. 3-4). The relevant issued claims of the '705 patent, found to be valid and infringed by the Courts below, were *never involved* in said interference and were fully and carefully considered by the Patent Office and granted to Caplan after the termination of the interference and with full knowledge thereof (R.App. 4; 28).

The fundamental difference between the facts of *Blonder-Tongue* and the case at bar is that the prior decision of the Patent Office Board of Patent Interferences in the Roberts-Caplan interference *did not involve the same issues* as were presented to the Courts below.* The claims of the '705 patent here in suit are directed to a totally different invention than were the counts of the Roberts-Caplan interference. (R.App. 3-5). This fact was recognized by the Patent Office in allowing the relevant claims of the '705 patent after the termination of the interference and with

*Another obvious difference between *Blonder-Tongue* and the present case is the fact that the "prior decision" relied upon by Petitioner (P. 3) was not a final determination of a Federal Court as to the validity of an issued patent, as in *Blonder-Tongue*, but merely an interlocutory decision by an administrative tribunal, made at one point during the prosecution of the application for the '705 patent.

full knowledge thereof (R.App. 28, 30). The same fact was also recognized by the Court of Appeals for the Sixth Circuit, which held in sustaining the validity of these claims, as follows (R.App. 4):

> "Goodyear's claim of prior invention rests primarily on Roberts' victory over Caplan in Patent Interference No. 91,640. This proceeding concerned an alleged conflict between Roberts' Patent No. 2,936,812 and claims 1 through 4 of Caplan's '705 patent. The Roberts patent prevailed, and the Caplan '705 application was therefore modified and, as modified, was the basis of the patent issued by the Patent Office. That agency specifically took notice of the interference proceeding, and held that Caplan's patent was valid nevertheless." [437 F.2d at 246]

Thus, rather than ignoring the results of the Roberts-Caplan interference, as Petitioner accuses them of doing (P. 9-14), the Courts below took specific cognizance not only of the interference, but of *all* other proceedings which transpired in the Patent Office and which resulted in the issuance of Respondent's '705 patent (R.App. 4; 28).

Petitioner, of course, chooses to ignore subsequent events in the progress of the application for the '705 patent through the Patent Office and focuses attention solely upon the interference. The Courts below, however, rightfully considered not only this isolated matter, but reviewed the entire prosecution of the application for the '705 patent, concluding, as did the Patent Office, that the claims *as ultimately presented and issued* therein were for a totally different and distinct invention from that involved in the counts of the interference (R.App. 3-5; 28, 30).

Therefore, the facts of the present case bear no resemblance to those of *Blonder-Tongue,* and it is respectfully submitted that neither the reasoning nor the decision in *Blonder-Tongue* has any application to the present case. Accordingly, no reason has been presented under Petitioner's Question One warranting the granting of the Petition for a Writ of Certiorari.

II

**THE COURTS BELOW CORRECTLY INTERPRETED AND APPLIED THE ROBERTS-CAPLAN INTERFERENCE COUNTS**

The second question which the Petition presents for this Court's consideration, reads as follows (P. 2):

> "Whether the Court of Appeals for the Sixth Circuit erred in failing to apply a count of a patent interference as prior art for what it plainly states on its face, and for what it clearly teaches the reader as though it were a page in a text."

In thus presenting its second question, Petitioner takes issue with the manner in which the Courts below interpreted and applied the broad count of the Roberts-Caplan interference (P. 15-21). Petitioner erroneously contends that the count (claim 16 of the '812 patent) of that interference should be read and considered in a vacuum, and without regard to the actual invention covered thereby, as disclosed in the specification and drawings of the Roberts '812 patent in which the claim or count originated. Thus, Petitioner would have this Court abandon a basic rule of patent claim construction which this Court and subordinate courts have consistently followed for over a hundred years.

This Court had occasion to restate its basic rule of claim construction in the case of *U.S.* v. *Adams,* 383 U.S. 39

(1966). In that case, in which this Court held the patent there involved to be valid, it was stated, at pages 48-49:

> "While the claims of a patent limit the invention, and specifications cannot be utilized to expand the patent monopoly, *Burns* v. *Meyer,* 100 U.S. 671, 672 (1880); *McCarty* v. *Lehigh Valley R. Co.,* 160 U.S. 110, 116 (1895), it is fundamental that claims are to be construed in the light of the specifications and both are to be read with a view to ascertaining the invention, *Seymour* v. *Osborne,* 11 Wall. 516, 547 (1871); *Schriber-Schroth Co.* v. *Cleveland Trust Co.,* 311 U.S. 211 (1940); *Schering Corp.* v. *Gilbert,* 153 F. 2d 428 (1946)."

The Court of Appeals for the Sixth Circuit held to the same effect in the case of *FMC Corporation* v. *F. E. Myers & Bro. Co.,* 384 F. 2d 4 (6 Cir. 1967) at page 13, where the Court stated:

> "And 'the claim of a patent must be read in the light of the invention disclosed and cannot be given a construction broader than the teachings of the patent as shown by the drawings and specifications.'"

The Court of Appeals in the present case properly followed the long-standing rule of claim construction set forth in *Adams,* stating (R.App. 4-5):

> "Any conflict between the language of claim 16 of the '812 patent and the '705 patent assumes significance only if the invention disclosed by the language, drawings, and specifications of the '812 patent conflicts with the invention claimed and disclosed in the '705 patent. *See e.g., FMC Corp.* v. *F. E. Myers & Bro. Co.,* 384 F. 2d 4, 13 (6th Cir.

1967). Here the District Court found, and we agree, that there was no such conflict.

*Anticipation by prior art.* Goodyear's claim of anticipation by prior art also rests primarily on Interference No. 91,640. It also argues that claims involved in an interference are prior art against the loser of the interference: *In re Risse*, 378 F.2d 948, 956 (CCPA 1967). But that proposition misses the point raised by plaintiff; that its invention, as ultimately patented, is inventively different from the Roberts '812 patent.

The facts, as found by the District Court, support plaintiff's contention. It found that the Roberts hose is preformed and hand-corrugated on a mandrel and then placed in a mold for curing and vulcanization. This process may be referred to as mold-curing. The Caplan hose, on the other hand, is mold-formed by putting the separate components in a mold, in which they are molded and vulcanized in the same operation. These findings are supported by evidence in the record and are not clearly erroneous." [437 F.2d at 246]

The authorities relied upon by the Petitioner on this point are inapplicable (P. 16-18). The Petitioner cites this Court's decisions in *Aro Manufacturing Co., Inc.* v. *Convertible Top Replacement Co. Inc.* 365 U.S. 336 (1961), and *Universal Oil Products Co.* v. *Globe Oil and Refining Co.*, 322 U.S. 471 (1944), and the decision of the Court of Appeals for the Sixth Circuit in the case of *Maxon* v. *Maxon Construction Company, Inc.*, 395 F.2d 330 (6th Cir. 1968), as standing for the proposition that the claims of a patent are the sole measure of the patent grant. With this general proposition, Respondent has no quarrel. But, Petitioner's argument misses the point.

The issue, in the case at bar, is not the extent of the patent grant conferred by the claims of a patent, as in *Aro, Universal* and *Maxon*. Rather, the issue presented in this case is whether or not the invention, as ultimately patented in the issued claims of the Caplan '705 patent, is inventively different from the invention of the Roberts '812 patent. And, for this determination, one must look to the entire disclosure of each patent, including the specification and drawings. This is the basic tenet of patent claim interpretation reaffirmed by this Court in *Adams* and applied herein by the Courts below.

The cases of *Phillips* v. *Lynch*, 367 F.2d 601 (CCPA 1966) and *Vogt* v. *McFeaters*, 341 F.2d 315 (CCPA 1965), from which Petitioner has carefully selected language used by the Court of Customs and Patent Appeals, are also inapposite. In *Phillips* and *Vogt*, the Court was simply stating that, under established Patent Office practice in interference proceedings between an issued patent and a pending application, the Board of Patent Interferences may not consider whether unambiguous claims or counts which originated in the issued patent are supported by the specification thereof or if such claims are, in fact, broader than the disclosed invention.* Neither *Phillips* nor *Vogt* dealt with the issue in the case at bar of whether the issued claims of the Caplan '705 patent are patentably distinct from the invention of the Roberts '812 patent. In such a situation, the rule espoused by this Court in *Adams* is applicable.

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*In the Roberts-Caplan interference, since the Roberts '812 patent had already issued prior to the interference, neither Caplan, nor the Board of Interferences itself, was in a position to challenge the breadth of claim 16 and the other Roberts claims involved in said interference. Thus the Board noted:

> "We can not, of course, consider whether the counts are broader than Roberts' invention (Trumbull et al. v. Kirschbraun, 21 CCPA 758, 67 F(2) 974, 1934 CD 191, 443 O.G. 567)." (Ex. Vol. 140g-140h)

In its efforts to convince this Court that claim 16, standing alone, discloses a separate and distinct method of making a flexible radiator hose apart from the single method disclosed in the Roberts '812 specification, Petitioner accuses the Courts below of engaging in a "strained interpretation" of claim 16 to limit it to the "preferred embodiment of the invention", as disclosed in the specification and drawings of the Roberts '812 patent (P. 8, 17). Instead, the Courts below simply recognized that there was *no support whatsoever* in the Roberts '812 patent for Petitioner's interpretation of claim 16 (R.App. 4-5; 25-26). Even Petitioner's expert witness repeatedly admitted at the trial below that *such interpretation,* as now urged by Petitioner, was *in no way supported* anywhere in the specification of the Roberts '812 patent (App. 284-285, 315).*

Petitioner attempts to gloss over the specific findings of the Courts below by relying heavily upon the cases of *In re Field,* 161 F.2d 372 (CCPA 1947); and particularly, *In re Risse,* 378 F.2d 948 (CCPA 1967), to argue that the interference count (claim 16 of the '812 patent) is prior art against the Caplan '705 patent (P. 18). The Court of Appeals below disposed of this very point, unanimously holding (R.App. 4):

> "*Anticipation by prior art.* Goodyear's claim of anticipation by prior art also rests primarily on Interference No. 91,640. It also argues that claims involved in an interference are prior art against the loser of the interference. *In re Risse,* 378 F.2d 948, 956, (CCPA 1967). But that proposition misses the point raised by plaintiff; that its invention, as ultimately patented, is inventively different from the Roberts '812 patent.

*References herein to the joint Appendix on appeal containing stipulated parts of the trial transcript are designated "App.".

> The facts, as found by the District Court, support plaintiff's contention." [437 F.2d at 246]

The Patent Office, in granting the relevant claims of the '705 patent after the Roberts-Caplan interference and with full knowledge thereof, specifically considered as part of the *prior art* the Roberts '812 patent including claim 16 thereof.* Thus, the Patent Office, the District Court and the Court of Appeals, in sustaining the validity of the '705 patent were all unanimous in finding that the claimed invention of the '705 patent was indeed clearly and inventively different from that embodied in the Roberts '812 patent. (R.App. 3-5; 25-26, 28, 30). Hence, *In re Risse* and the other Court of Customs and Patent Appeals authorities relied upon by the Petitioner (P. 16-18) have no application to the case at bar.

It is apparent from the arguments advanced by Petitioner in support of the issues framed by its Question Two (P. 15-21) that Petitioner, dissatisfied with the factual findings made by the Courts below as to the nature of the Caplan invention of the '705 patent, seeks in this Court a review *de novo* of the factual evidence presented below and the findings based thereon. Petitioner, however, is not entitled to such a review here, as this Court clearly ruled in the case of *Zenith Radio Corp.* v. *Hazeltine Research, Inc.*, 395 U.S. 100 (1969).

Thus, it is respectfully submitted that the Courts below correctly and properly interpreted and applied the language of claim 16 of the Roberts '812 patent in sustaining the validity of the relevant claims of the '705 patent, and that Petitioner's arguments to the contrary are without merit. Hence, no reason has been presented under Petitioner's Question Two, warranting the grant of the Petition for a Writ of Certiorari.

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*This is in accord with the holdings of the CCPA in *Field* and *Risse*, as quoted in the Petition (P. 17, 18).

## III

## THE PETITION SHOULD BE DENIED BECAUSE OF UNTIMELY FILING IN VIOLATION OF THE APPLICABLE STATUTE, 28 USC 2101 (c)

The Petition is not only factually and legally without merit, but it is also untimely, since it was filed beyond the time limit prescribed by the applicable statute, 28 USC 2101 (c), which states:

> "Any other appeal or writ of certiorari intended to bring any judgment or decree in a civil action, suit or proceeding before the Supreme Court for review shall be taken or applied for within ninety days after the entry of such judgment or decree. A justice of the Supreme Court, for good cause shown, may extend the time for applying for a writ of certiorari for a period not exceeding sixty days."

In the present case, the judgment of the Court of Appeals for the Sixth Circuit, to which the Petition is directed, was entered on *January 27, 1971*, and an order of that Court, denying a petition for rehearing was entered on *April 16, 1971*. Thus, the present Petition was due for filing in this Court on or before *July 15, 1971*, within the ninety (90) day period allowed by the applicable statute, 28 USC 2101 (c). However, the present Petition for Writ of Certiorari, though timely served by mail upon Respondent's counsel, was not docketed in this Court until *July 20, 1971*, ninety five (95) days after the entry of the order of the Court of Appeals for the Sixth Circuit, denying the petition for rehearing. Petitioner did not apply for nor was it granted any enlargement of the ninety (90) day period in which to file the present Petition pursuant to Rule 34 of this Court. Nor has any reason been advanced by Petitioner for its late filing in this Court. Hence, the filing

of the Petition was untimely, and in view thereof, the Petition should be denied. *Department of Banking* v. *Pink*, 317 U.S. 264 (1942).

## CONCLUSION

For the reasons stated, and under the authorities cited, the Petition is without merit, as well as untimely, and it should be denied.

Respectfully submitted,

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## APPENDIX A

COURT OF APPEALS, SIXTH CIRCUIT.

H. K. PORTER COMPANY, INC. v. THE GOODYEAR TIRE & RUBBER COMPANY.

No. 19911

Decided Jan. 27, 1971

Before: Phillips, Chief Judge, Weick and McCree, Circuit Judges.

McCree, Circuit Judge.

The Goodyear Tire and Rubber Company appeals from a judgment declaring valid and infringed certain patents for the manufacture of "Flexible Hose," a product designed as a replacement for factory-installed original equipment automobile radiator hose.

On August 21, 1962, United States Patent No. 3,050,087 was granted to David M. Caplan as inventor of "Flexible Hose," and three years later, on July 13, 1965, Patent No. 3,194,705 was granted to him as inventor of a method and apparatus for manufacturing this flexible mold-formed radiator hose. Five months later, H. K. Porter Company, the current owner of both patents, brought this action against Goodyear, charging infringement of both the '087 and '705 patents. Goodyear denied infringement and attacked the validity of the patents. After an extensive trial, the District Court held the patents valid and infringed, and granted declaratory and other injunctive relief. We affirm.

Replacement radiator hoses play an important role in the automobile repair field. Original equipment hoses often

fail because of internal pressure, vacuum collapse, the corrosive effect of radiator additives on rubber tubing and other causes. These hoses are designed to the specifications of a particular make and model of automobile. Replacement hoses, on the other hand, to be commercially successful, must be capable of substantial standardization. They must not only be able to resist bursting under pressure and to avoid vacuum collapse, but they must also resist bending collapse when they are contorted to permit their being fitted into the varying distances between the engine blocks and radiators of different manufacturers' cars. These technical challenges stimulated intensive inventive activity, some of which gave rise to this litigation.

Considerations of flexbility mandated the use of a material possessing this characteristic of rubber and having sufficient strength to resist bursting under pressure and resistance to the corrosive effect of radiator additives. Also, rigidity is necessary to avoid vacuum collapse, and this requirement presented a difficult problem. In original equipment radiator hoses, an internal spring is commonly used to impart this property. However, original equipment hoses are of uniform length and need not possess the flexibility for adjustment of length as must replacement hoses. Accordingly, the internal spring device was found unacceptable and an external helical reinforcing wire coil spring was considered to give the desired rigidity without preventing flexibility. The precise problem concerned finding a commercially feasible method of incorporating this coil spring appropriately into the rubberoid body of the hose.

Caplan testified that he accomplished this in the following manner;

> A. What we have here is a radiator hose formed of its component parts—I should say simultaneously

formed and cured of its component parts, and has a section that is interiorly and exteriorly convoluted, that has a reinforcement embedded in the apex of those convolutions, and the only covering over that reinforcement is part of the same material which was used to form the body of the tube.

Q. Is that what you consider to be your invention?

A. Well, I'm not great shakes on these statements, but all I know is that I took something that wasn't there and made it and it was a success in the field and made a great difference in the industry. I think it was invention.

Goodyear, which produced a similar product, challenges the validity of the patents in suit on three grounds: prior invention and disclosure; anticipation by the prior art; and obviousness. It also asserts as a defense against the infringement claim the doctrine of file wrapper estoppel. We consider each of these grounds separately, and conclude that the patents are valid and that they have been infringed.

*Prior invention and disclosure.* Goodyear claims that one Robert E. Roberts invented the same process before Caplan, and that he disclosed this invention to Caplan and to plaintiff's predecessor in interest, the Voit Rubber Company, in 1950 and 1951. Here, the issue of disclosure presents a question of fact, because evidence was introduced in support of the contentions of both parties. The District Court resolved the factual conflict against Goodyear, and its findings are not clearly erroneous. Rule 52(a), Fed. R. Civ. P.

Goodyear's claim of prior invention rests primarily on Roberts' victory over Caplan in Patent Interference No. 91,640. This proceeding concerned an alleged conflict be-

tween Roberts' Patent No. 2,936,812 and claims 1 through 4 of Caplan's '705 patent. The Roberts patent prevailed, and the Caplan '705 application was therefore modified and, as modified, was the basis of the patent issued by the Patent Office. That agency specifically took notice of the interference proceeding, and held that Caplan's patent was valid nevertheless. The decisions of the Patent Office, of course, enjoy a strong presumption of validity under 35 U. S. C. § 282. *Simplicity Mfg. Co.* v. *Quick Mfg., Inc.*, 355 F. 2d 1012, 1014 (6th Cir. 1966). Here the District Court found that all of the elements of the challenged claims of the '705 patent were not found in the Roberts '812 patent, or in any other single one of the five prior patents relied on by Goodyear, and this finding is supported by evidence in the record. Any conflict between the language of claim 16 of the '812 patent and the '705 patent assumes significance only if the invention disclosed by the language, drawings, and specifications of the '812 patent conflicts with the invention claimed and disclosed in the '705 patent. *See e.g., FMC Corp.* v. *F. E. Myers & Bro. Co.*, 384 F. 2d 4, 13, (6th Cir. 1967). Here the District Court found, and we agree, that there was no such conflict.

*Anticipation by prior art.* Goodyear's claim of anticipation by prior art also rests primarily on Interference No. 91,640. It argues that claims involved in an interference are prior art against the loser of the interference. *In re Risse*, 378 F. 2d 948, 956 (CCPA 1967). But that proposition misses the point raised by plaintiff; that its invention, as ultimately patented, is inventively different from the Roberts '812 patent.

The facts, as found by the District Court, support plaintiff's contention. It found that the Roberts hose is preformed and hand-corrugated on a mandrel and then placed in a mold for curing and vulcanization. This process may

be referred to as mold-curing. The Caplan hose, on the other hand, is mold-formed by putting the separate components in a mold, in which they are molded and vulcanized in the same operation. These findings are supported by evidence in the record and are not clearly erroneous.

Appellant contends that the clearly erroneous standard for reviewing findings of fact, mandated by Rule 52(a), Fed. R. Civ. P., is inapplicable with reference to findings based solely on documentary evidence. The law in this Circuit is well settled to the contrary. *United States Steel Corp.* v. *Fuhrman,* 407 F. 2d 1143, 1145-46 (6th Cir. 1969); *Commissioner* v. *Spermacet Whaling & Shipping S/A,* 281 F. 2d 646 (6th Cir. 1960).

*Obviousness.* Under 35 U. S. C. § 103, a patent cannot be held valid if the subject matter, although different from the prior art, is such that it would have been obvious to a person of ordinary skill. Goodyear, again relying on the Roberts '812 patent, contends that Caplan's invention is obvious under the test established in *Graham* v. *John Deere Co.,* 383 U. S. 1 (1966). In that case the Supreme Court described the inquiries required by § 103:

> Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy.

383 U. S. at 17-18.

In the case at bar, the factual findings required by § 103 were made by the District Court. Then the Court concluded:

> 58. The Court finds that the Caplan inventions, as exemplified in the '087 and '705 patents, would not have been obvious to a man skilled in the radiator hose art in 1953 to 1954. The combination of these isolated features of the prior art and original additions thereto, which produced the '087 and '705 patents, would not have been obvious to one skilled in the radiator hose art. In this connection, it is relevant that the Caplan inventions enjoyed immediate and substantial commercial success. They increased the production rate of flexible radiator hoses significantly. Upon introduction into the market, they immediately began to replace the prior hand-built corded fabric hoses. Indeed, the defendant itself was a substantial customer of the Caplan hoses. Prior to the Caplan inventions, the defendant and many others made long and unsuccessful efforts to develop hoses of their own. The existing flexible rubber hoses were unsatisfactory, were expensive, and difficult to produce. There was a long-felt need for an improved and economical flexible radiator hose, and many individuals have attempted to produce one over an extensive period of time. The evidence of a long-felt need and substantial efforts by many individuals to produce an improved flexible radiator hose gives weight to the Court's inference and conclusion that the Caplan inventions would not have been obvious to a person skilled in the flexible radiator hose art in 1953 and 1954. Rather, the Court has concluded that the Caplan inventions were novel, creative, and inventive and were, indeed, surprising to those skilled in the art at the time they were developed.

This conclusion is supported by the facts found and is correct under applicable law.

*File wrapper estoppel.* Goodyear argues that the doctrine of file wrapper estoppel prevents H. K. Porter from objecting to Goodyear's product, because it incorporates features which were abandoned by Caplan in the process of and for the purpose of obtaining a patent from the Patent Office. *See Kaiser Industries Corp.* v. *McLouth Steel Corp.*, 400 F. 2d 36 (6th Cir. 1968). Specifically, Goodyear claims that the Caplan patents are limited to "all-rubber" or "single layer" hoses. This contention is without merit. As the District Court found, neither Caplan patent is so limited, and the knit fabric reinforcement employed by Goodyear on its hose is not inventively distinguishable from that patented by Caplan. The District Court also rejected Goodyear's contentions that its wire-reinforcement differed from that in plaintiff's hose and that its hose does not radially expand during the mold-forming process as plaintiff's hose does.

Goodyear does not strenuously argue that there was no infringement if the patent is held valid. We agree with the District Court's findings of fact and conclusions of law, and we affirm that court's decision that the patents in question are valid and have been infringed. The judgment of the District Court is affirmed, and the cause remanded to the District Court for such further proceedings as may be necessary.

Affirmed and remanded.

IN THE UNITED STATES COURT

Northern District of Ohio

Eastern Division

* * (Caption—No. C 65-752) * *

Lambros, District Judge

I. Findings of Fact

*1. This is an action for infringement of United States Patent No. 3,050,087. This patent granted August 21, 1962, to one David M. Caplan, as inventor, related to a flexible rubber hose. The application for this patent was filed March 22, 1957, as a continuation of an earlier application filed February 1, 1954. The complaint also charges infringement of United States Letters Patent No. 3,194,705, granted July 13, 1965, also to David M. Caplan and relating to the "Method and Apparatus for Making Reinforced Corrugated Hose." The application for this patent was filed March 8, 1957, as a division of an earlier application filed February 1, 1954.

2. Plaintiff, H. K. Porter Company, Inc. (Porter) is the owner, by assignments, of the '087 and '705 patents. Defendant Goodyear Tire & Rubber Company (Goodyear), is an Ohio corporation, having a regular and established place of business located in Akron, Ohio, within the Eastern Division of the Northern District of Ohio.

3. This Court has jurisdiction as to the parties to, and the subject matter of, this action under the patent laws of the United States, Title 35, U. S. C. A., §§ 271, 282, 283, 284, 285, and Title 28, U. S. C. A., §§ 1338(a) and 1400(b).

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*The District Court's Findings and Conclusions were not numbered. Numbers have been inserted by defendant-appellant for ease of reference in the briefs.

4. The '087 patent claims a flexible mold-formed hose used as replacement hose on the radiators of automotive vehicles. The flexible molded radiator hose disclosed in this patent has two generally cylindrical ends. The hose itself is corrugated. The body of the hose is composed primarily of rubber or like material, and a helical reinforcing wire coil spring is embedded in the rubber body. This spring has its turns positioned in and secured to the crests of the helical corrugations of the rubber body. The wire coil has a portion of its outer surface disposed contiguous to the outer surface of the crests of the rubber body and completely surrounded by a portion of the rubber body. The ends of the coil spring extend to the ends of the hose, which are covered by fabric sleeves.

5. The construction of this hose, as disclosed in the '087 patent, is such that the hose may be readily bent to conform to the available space adjacent the radiator of an automobile. Also by reason of its construction, the hose is resistant to bursting pressures and to both bending collapse and vacuum collapse.

6. Of the nine claims of the '087 patent, plaintiff relied at the trial only on claims 1 and 2. They are as follows:

*Claim 1.*

"1. A mold-formed flexible hose comprising an interiorly and exteriorly corrugated tubular body molded from thermosetting plastic material, the exterior corrugations being defined by ridges and intervening valleys, the crests of said ridges, in cross-section axially of said hose, having a continuous, smooth, arcuate, mold-formed outer surface free of protuberances and added material, and wire-like reinforcing means encircling said body and secured to said ridges at the

crests thereof, said reinforcing means having a portion of its outer surface substantially immediately contiguous the outer surface of said crests and being completely surrounded by thermoset plastic material, the thickness of said material radially outwardly of said reinforcing means being less than the thickness thereof radially inwardly of said reinforcing means."

*Claim 2.*

"2. A flexible hose as set forth in Claim 1 in which said ridges are helical and said reinforcing means is a helical coil of wire."

7. The '705 patent relates to a method for forming a finished, unitary, flexible molded corrugated wire-reinforced rubber hose, such as is diclosed in the '087 patent in a single mold-forming operation.

8. A typical procedure which may be followed in forming the flexible molded corrugated wire-reinforced rubber hose by the method disclosed in the '705 patent is set forth in the illustrative chart (PX 32), prepared by plaintiff's expert, Dean Fischer (TR 443-444).

9. Of the seventeen claims of the '705 patent, plaintiff relied at the trial upon method claims 1, 2, 3, 5, 6, 13, 14, 15, and 16. Plaintiff relied more specifically upon claims 1, 3 and 14 as representative of this group of claims:

*Claim 1.*

"1. A method of fabricating a hose of thermosetting plastic material with circumferential turns of wire reinforcement means embedded therein, characterized by the use of a hollow mold with a helically corrugated

interior circumferential wall and including the steps of: placing a tube of thermosetting plastic material in said mold with said wire reinforcement means surrounding the tube in the mold and free of engagement with said tube at portions corresponding to the helically corrugated interior wall of said mold; sealing off the interior of the tube from the interior of the mold; introducing fluid under pressure into said tube for the purposes of providing pressure to expand the tube radially; supplying heat to said tube to cause material of the expanded tube to flow around the turns of said reinforcement means into contact with the surrounding mold walls to assume the configuration of the mold; and supplying heat to cure the plastic material of the expanded tube."

*Claim 3.*

"3. A method of fabricating a helically corrugated hose of thermosetting plastic material with circumferential turns of wire reinforcement means embedded therein, said method being characterized by the use of a hollow mold with a helically corrugated interior circumferential wall and including the steps of: placing a tube of thermosetting plastic material inside the turns of said wire reinforcement means; placing the assembly of tube and wire reinforcement means in said mold with the internal surface of said turns of wire in radially spaced relation to the external surface of said tube and with the turns of said wire reinforcement means freely disposed within the helical corrugations of said mold; and with the interior of the tube sealed off from the interior of the mold, introducing fluid under pressure into said tube and also applying heat to said tube for the purposes of, first, expanding the tube radially outward thereby causing the plastic

material to engage and flow around the turns of the reinforcement means to embed the reinforcement means, second, forming the assembly to the configuration of the interior of the mold, and third, at least partially curing the plastic material in the expanded configuration."

*Claim 14.*

"14. A method for the manufacture of reinforced helically corrugated hose which comprises placing in a hollow internally corrugated mold the components of said hose before said components are formed into a hose, said components comprising a tubular member of elastomeric material, and a reinforcing member having axially spaced turns whose interior diameter is greater than the exterior diameter of said tubular member, said reinforcing member being disposed in said mold surrounding said tubular member with the axially spaced turns of said reinforcing member in alignment with and freely positioned within the valleys of the corrugations of said mold in radially spaced relation to said tubular member, and uniting and forming said components into a hose, by subjecting said tubular member to internal pressure accompanied by heating to cause it to expand and soften and conform to the shape of said mold while simultaneously flowing around and embedding said turns therein and to at least partially set the material of said tubular member."

11. David M. Caplan is the patentee of the '087 and '705 patents. In January, 1951, he entered the employ of the W. J. Voit Company in California. Voit was at that time manufacturing and selling a so-called corded flexible radiator hose. This was a thin-walled, fabric-covered hose made largely by hand operations.

12. In the manufacture of the corded flexible radiator hose, a tube of rubber is placed on an inflatable mandrel and a closed coil wire spring is positioned over the rubber tube. The wire spring is manually spaced along the rubber tube. The building mandrel is then inflated, expanding the rubber tube and holding it tightly against the wire spring. The entire hose assembly is then cemented and an end strip is placed at each end of the hose assembly to form the built-up ends of the finished hose. A fabric cover is then hand-wound over the entire length of the rubber tube and wire spring to form the outer cover of the hose. With the fabric cover in place, the components of the hose are then solidified by a stitching operation in which an elastic band is hand-wrapped around the entire hose assembly to eliminate any entrapped air and to form the components into a compact hose assembly. The building mandrel is then deflated and the stitching band removed.

13. The hose assembly is then transferred to a "cording" mandrel. The hose assembly is positioned on the cording mandrel and encased in a so-called "wet wrap" by manually wrapping a wet strip of nylon or cotton fabric. After the "wet wrap" is in place, a length of regular sash cord is tightly hand-wound around the hose assembly between the spring coils. It is necessary to apply substantial pressure in the cording operation, since the "cording," in effect, formed the hose convolutions by depressing the body of the hose assembly between the coils of the wire spring. The cording operation also resulted in some decrease in the length of the hose.

14. With the cord tightly in place, the entire hose assembly, while still on the cording mandrel, is placed in a steam vulcanizer and subjected to a steam atmosphere for

a period of from 30 to 55 minutes, with an average time of about 45 minutes being required in the vulcanizer. Upon completion of the vulcanizing operation the sash cord is manually removed from the outside of the cured hose. Thereafter, the wet-wrap is manually removed and the cured hose is stripped from the cording mandrel.

15. This type of hose (and the process by which it was manufactured) presented a number of problems. The amount of convoluting and its attendant decreasing in the length of the hose in the cording operation varied from operator to operator and from day to day so that the completed hoses were not uniform in length or appearance. In addition, the corded radiator hose readily lost adhesion between the outer fabric cover and the inner tube. This resulted in failure of the hose in use, since the loss of adhesion between the outer fabric cover and the inner tube stock would cause the wire coil spring to cut through the tube. Furthermore, the manufacture of the corded hose was essentially a manual operation. It was slow, laborious and uneconomical. There was a demand for a better hose for the automotive radiator hose replacement trade and for a more efficient and more economical method of making such a flexible replacement hose.

16. Because of the problems experienced by his employer, Voit, with its hand-built corded flexible radiator hoses, and the demand which existed in the trade for a better flexible radiator replacement hose, Caplan undertook in the period 1952-1953 to improve upon the prior art, and to develop a new and better hose than the hand-built corded hose. In the course of this development work, Caplan conceived the idea of an entirely mold-formed hose in which the components of the hose, including a rubber

tube and an open-coil wire reinforcing spring, are separately assembled and placed in a convoluted mold and are formed in the convoluted mold into a completed, unitary flexible hose in a single mold-forming operation.

17. Following this development work, Caplan interested his employer, Voit, in the manufacture of his flexible mold-formed radiator hose. Voit set up facilities for the commercial production of Caplan's mold-formed radiator hose. Initially a pilot plant operation was set up in Los Angeles, California. Specimens of the Caplan flexible molded radiator hose, made by this pilot plant, were subjected to field testing in which they performed very satisfactory.

18. Sometime late in 1954 Voit set up commercial operations for making the Caplan hose in Danville, Illinois; and early in 1955, Voit started to sell the Caplan hose. The Caplan hose quickly began to replace the hand-built corded flexible radiator hose.

19. Sometime in late 1956 Voit sold its business of manufacturing the Caplan hose, including its plant at Danville, Illinois, and the molds and other equipment therein, to the Thermoid Company. Subsequently, the plaintiff acquired Thermoid, including the Danville plant, and continued thereafter to manufacture and sell the Caplan mold-formed flexible radiator hose. While remaining an employee of Voit, Caplan continued his connection with the Danville plant under Thermoid ownership until sometime in 1958 during which time he provided technical assistance to Thermoid employees in the manufacture of the Caplan hose.

20. After Thermoid acquired the Danville plant of Voit, it discontinued the manufacture of the hand-built corded

flexible radiator hose which it had previously manufactured and sold, and converted its entire commercial production of automotive radiator hoses at its Danville plant to the Caplan hose. Since 1957 the corded fabric radiator hose has no longer been commercially made or sold by the plaintiff or by the defendant.

21. The Caplan mold-formed flexible radiator hose manufactured by the Voit Company at its Danville plant, the hose as manufactured by Thermoid (and later by the plaintiff) at its Danville plant in the period 1957-1960, and the hose manufactured and sold by plaintiff since 1960 all embody the construction defined in claims 1 and 2 of the '037 patent and were made by the method of the '705 patent (as defined in claims 1, 3 and 14 thereof).

22. During the period from approximately 1952 to 1956, inclusive, Thermoid sold to the defendant hand-built, corded flexible radiator hose. After Thermoid acquired the Danville plant from Voit, Thermoid manufactured and sold to the defendant its mold-formed radiator hose. After the plaintiff acquired the Danville plant from Thermoid, plaintiff continued to manufacture and sell mold-formed radiator hose to the defendant until some time in the year 1965.

23. During the years 1957 to 1965, inclusive, the plaintiff and its predecessor, Thermoid, manufactured and sold flexible mold-formed radiator hose in substantial quantities to the defendant and others.

24. In the first quarter of 1960 the plaintiff began the manufacture and sale of a flexible mold-formed radiator hose embodying a longitudinally-extending cord reinforcement. Since then, plaintiff has continued to manufacture

and sell such cord-reinforced flexible mold-formed radiator hose. The addition of the longitudinal cord-reinforcement to the all-rubber mold-formed flexible radiator hose previously manufactured and sold by the plaintiff, as exemplified by PX 22, did not change in any way the method employed by the plaintiff at its Danville, Illinois plant in mold-forming its flexible radiator hoses. The methods employed by the plaintiff in making both types of hoses were substantially the same, except for the preliminary step of incorporating cord-reinforcement in the "green hose."

25. The substantial sales of the all-rubber flexible mold-formed radiator hose and of the cord-reinforced flexible mold-formed radiator hose establish that both of these hoses were commercially successful and were acceptable and usable automotive radiator replacement hoses.

26. The plaintiff gave actual notice in writing to the defendant as to the '087 patent on or about May 27, 1965, and the plaintiff notified the defendant as to the issuance of the '705 patent on or about August 26, 1965. Plaintiff gave further notice to the defendant as to the '705 patent by the filing of the complaint herein in November, 1965.

27. The plaintiff began marking its flexible molded radiator hose with the number of patent No. 3,050,087 sometime in the fall of 1962. This was done by incorporating the number of patent No. 3,050,087 in the molds employed in making plaintiff's hose.

28. Sometime in September, 1965, the plaintiff began marking its flexible molded radiator hose with the number of patent No. 3,194,705; and the plaintiff continued there-

after at all times material hereto to mark its flexible molded radiator hose with the number of patent No. 3,194,705.

29. The defendant's hose is formed from a so-called "green hose." This consists of an all-thermoplastic inner tube over which a loose fabric knit is applied. These two components are covered with a thermoplastic tubular layer to form the complete so-called "green hose."

30. The only difference between the construction of the defendant's flexible mold-formed radiator hose and the flexible mold-formed radiator hose disclosed in the '087 patent relates to the incorporation in defendant's flexible mold-formed radiator hose of the knit fabric reinforcement. This knit reinforcement increases the strength of the defendant's hose and its resistance to bursting pressures when used in the radiator system of an automotive vehicle. It does not in any substantial or significant way change the function, mode of operation or manner of use of the defendant's flexible mold-formed radiator hose as compared to the flexible mold-formed hose disclosed in the '087 patent, and as defined in claims 1 and 2 of the '087 patent.

31. Defendant contends that its flexible radiator hose does not come within the scope of claims 1 and 2 of the '087 patent because the wire reinforcement of defendant's hose is "embedded" in the hose convolutions, whereas the language of claim 1 of the '087 patent calls for the wire to be "secured to" the ridges of the hose at the crests. However, an inspection of defendant's hoses reveals that the spring coils in defendant's hose are located in the crests of the hose, with portions of the spring coils contiguous to the outer surface of the crests and completely surrounded by the thermoset plastic material of the "green hose."

They are, therefore, "secured to" the ridges of the hose in the crests thereof, in the same sense and to the same extent as is recited in claim 1 of the '087 patent.

32. Defendant also contends that, in its method of making its mold-formed flexible radiator hose, the wire coil reinforcing spring does not have the degree of radial spacing or freedom from engagement with the "green hose" as is disclosed between the spring and the green tube in the illustrative drawings of the '705 patent. However, the evidence, including the testimony of plaintiff's expert, Dean Fischer, shows that in defendant's method of making its flexible mold-formed radiator hose there is sufficient radial spacing or freedom of engagement between the wire coil reinforcing spring and the "green hose" to enable the coils of the wire-reinforcing spring to be adjusted longitudinally along the "green hose" so that the spring coils can be properly positioned in the valleys of the mold corrugations.

33. Claims 1, 3 and 14 of the '705 patent do not recite the *degree* of radial spacing or freedom of engagement between the green hose or rubber tube and the wire-reinforcing spring. The only requirement of the '705 patent (as construed in the light of the specification and drawings thereof) is that there be sufficient freedom between the "green hose" and the coils of the wire coil reinforcing spring to enable the wire coil reinforcing spring to be readily adjusted along the "green hose" so as to properly distribute the spring coils in the valleys of the mold corrugations, thus insuring that there is only one coil seated in each mold convolution. This is necessary to avoid wires crossing the mold convolutions, thereby producing a defective hose.

34. Defendant also contends that there is no radial expansion of its "green hose" during the process of forming its hose. However, a visual comparison of defendant's "green hose," as it appears before the mold-forming operation, with the defendant's finished hose, as it appears after the mold-forming operation, reveals that radial expansion has, in fact, occurred in the process of making defendant's hose, and particularly in those portions of the "green hose" which correspond to the crests of the finished hose.

35. In this connection, the Court notes that the manufacturing tolerances for the defendant's "green hose," as contained in its specifications for an acceptable "green hose," provide for a "green hose" having an external diameter which can be *smaller* than the minimum internal diameter of defendant's mold. Also, the external diameter of defendant's "green hose," according to its specifications, is *always* smaller than the maximum internal diameter of defendant's mold.

36. Defendant also contends that the inclusion of the knit reinforcement in its "green hose" distinguishes its process for forming flexible radiator hoses from the process defined by claims 1, 3 and 14 of the '705 patent. This contention by defendant is without merit, since the only requirement of the disclosure and claims of the Caplan '705 patent is that the "green hose" be formed principally or chiefly of rubber or similar thermoplastic material, so that, during the mold-forming process, at least a portion of the thermoplastic material of the "green hose" will soften and flow sufficiently to cover the reinforcing spring and conform to the shape of the convoluted mold. This teaching of the Caplan patent is followed in defendant's process.

37. The Court has concluded that the defendant's flexible hose was developed with full knowledge of the plaintiff's flexible hose and of the patents underlying it. Furthermore, the Court has concluded that the defendant attempted to duplicate the plaintiff's flexible hose both in method, structure, and performance without infringing upon the plaintiff's patents. The record is replete with evidence supporting these findings. Indeed, the evidence indicates that the defendant's development process became progressively more similar to the plaintiff's patented method and structure. Statements and correspondence of the defendant's own agents indicate, that the defendant's accused article and method is patterned after the plaintiff's patented article and method.

38. The defendant, at the trial, attempted to demonstrate that Mr. Caplan was not the original inventor of the matter disclosed in the '087 and '705 patents. Defendant asserted that one Robert E. Roberts developed this knowledge sometime in 1950 or 1951, and that he disclosed it to Caplan and a number of other Voit employees. It is the Court's conclusion that the evidence does not support this position. The Court finds that Caplan had no knowledge of any of Roberts' developments at the time he discovered the information underlying the '087 and '705 patents. Rather, the Court finds that Caplan made these developments and discoveries on his own and without the benefit of any knowledge referrable to Robert E. Roberts. Caplan's work was entirely independent of Roberts and did not rely upon Roberts in any significant way.

39. At the trial the defendant relied upon the following patents in support of its defenses (under Title 35, U. S. C. A., §§ 102 and 103) to claims 1 and 2 of the '087 patent:

| Patent No. | Patentee | Title | Date |
|---|---|---|---|
| 314,400 | Eames | Hose or Tubing | March 24, 1885 |
| 375,877 | Judson | Rubber Hose | January 3, 1888 |
| 2,248,898 | Ross | Metliod of Making Rubber Articles | July 8, 1941 |
| 2,272,704 | Harding | Method and Apparatus for Making Corrugated Tubes | February 10, 1942 |
| 2,396,059 | F. T. Roberts | Flexible Tube | March 5, 1946 |
| 2,570,259 | McKinley | Method of and Apparatus for the Manufacture of Flexible Conduits | October 9, 1951 |
| 2,936,812 | R. E. Roberts | Method and Apparatus for Making Flexible Corrugated Reinforced Hose | May 17, 1960 |
| 227,373 (British) | Kort | Improvements Relating to the Manufacture of Hose Pipes of Rubber or the Like | January 15, 1925 (Complete Accepted) (Printed, 1925) |

40. At the trial the defendant relied upon the following patents in support of its defenses (under Title 35, U. S. C. A., §§ 102 and 103) to the claims of the '705 patent:

| Patent No. | Patentee | Title | Date |
|---|---|---|---|
| 314,400 | Eames | Hose or Tubing | March 24, 1885 |
| 375,877 | Judson | Rubber Hose | January 3, 1888 |
| 2,248,898 | Ross | Method of Making Rubber Articles | July 8, 1941 |
| 2,272,704 | Harding | Method and Apparatus for Making Corrugated Tubes | February 10, 1942 |
| 2,300,441 | Voit | Method of Making Athletic Balls | November 3, 1942 |
| 2,936,812 | R. E. Roberts | Method and Apparatus for Making Flexible Corrugated Reinforced Hose | May 17, 1960 |
| 227,373 (British) | Kort | Improvements Relating to the Manufacture of Hose Pipes of Rubber or the Like | January 15, 1925 (Complete Accepted) (Printed, 1925) |

41. The Eames patent (No. 314,440, issued Mareh 24, 1885) discloses a railroad vacuum brake hose. As shown in the patent drawings, all of the material of the Eames hose is outside of the reinforcement wire and the wire is not located within the body of the hose material. This arrangement of hose components is unsuitable for a hose under positive fluid pressure since such pressure would cause the hose wall material to separate from the wire. Furthermore, Eames taught the art to *avoid* the use of hose in which the wire is "entirely embedded" in the hose material. Eames, we note, recognized the equivalence between all-rubber and composite (fabric and rubber) hose materials in the rubber hose art.

42. The Judson patent (No. 375,877, issued January 3, 1888) discloses a railway *pressure* brake hose. The Judson hose is externally, but not internally, corrugated. This makes the Judson hose relatively stiff and inflexible and thus unsuitable as an automotive radiator replacement hose. An essential teaching of Judson is that layers of canvas or other equivalent heavy fabric should be placed both outside and inside the reinforcement wire. Judson's wire is "entirely embedded" in the material of the hose wall.

43. The Ross patent (No. 2,248,898, issued July 8, 1941) discloses and claims a process of making gas mask tubes from inelastic gels which are capable of plastic flow in the wet gel state under stress. No wire reinforcement for the tubes is disclosed or suggested in Ross. Only low pressure air, but not steam or hot air, is used during the expansion step in the mold of Ross. After the expansion step in the mold, Ross removes water from the gel by synaeresis prior to the vulcanization or curing step. The Ross patent was specifically considered by the Patent Office in connection with the application for the Caplan '705 patent.

44. The Harding patent (No. 2,272,704, issued February 10, 1942) disclosed and claimed a method and apparatus for making corrugated rubber tubes. The Harding process involves shaping or forming the corrugated tube on a corrugated mandrel prior to curing the preformed tube in a vulcanizing chamber, instead of using a mold. No wire reinforcement for the corrugated tube is disclosed or suggested anywhere in Harding.

45. The Voit patent (No. 2,300,441, issued November 3, 1942) discloses and claims a multi-step method of making athletic balls, such as basketballs, utilizing a plurality of separate forming and vulcanizing steps. The balls disclosed by Voit have no corrugations, externally or internally, and contain cord, yarn or thread reinforcement rather than any metallic wire reinforcement. The Voit balls are always provided with wear-resistant covers after they are cured in molds.

46. The Roberts patent (No. 2,396,059, issued March 5, 1946) discloses a flexible gas mask tube, the corrugations of which are formed by a cording or hand-wrapping step prior to a separate vulcanizing step. The utility of the hoses of this patent relates to applications requiring tubing which can be readily stretched lengthwise, such as in oxygen helmets and anesthetizing apparatus. The closed coil spring used in making the Roberts tube is engaged to the inner tube by tape and/or cement and is under considerable tension in the end product. An outer fabric cover, or stockinet, is used in making the Roberts gas mask tube. The thickness of the tube material radially outward of the wire reinforcement is substantially the same as the thickness thereof radially inward of the wire. The Roberts '059 patent was specifically considered by the Patent Office in connection with the application for the Caplan '087 patent.

47. The McKinley patent (No. 2,570,259, issued October 9, 1951) discloses and claims a method and apparatus for making flexible vacuum cleaner hose. McKinley's conduit is not mold-formed, but an outer wire helix is used for cording down the hose between its reinforcement wire coils to form the external corrugations in the hose prior to the vulcanizing or curing step. The inner surface of the finished McKinley hose is "completely smooth" and uncorrugated. This McKinley patent was specifically considered by the Patent Office in connection with the application for the Caplan '087 patent (PX 3, page 43).

48. The Roberts Patent No. 2,936,812 was issued on a continuation-in-part application, filed September 3, 1957, of the Roberts parent application, filed May 21, 1954. The Roberts parent application was filed three months later than the Caplan parent application, which was filed February 1, 1954. Claims 16 to 19, inclusive, of Roberts '812 were added for the first time when the Roberts continuation-in-part application was filed in 1957.

49. Roberts patent '812, issued May 17, 1960, discloses and claims a method and apparatus for making flexible corrugated wire-reinforced hose. Roberts discloses only one method of making the several constructions of his hose. In the Roberts method, the hose corrugations are formed on an inflatable, convoluted forming mandrel in a separate "forming" or cording step, prior to "setting," i.e., vulcanizing or curing, the already "formed" hose in a mold. Claims 16 to 19, inclusive, of Roberts '812 define in broad terms the method disclosed by Roberts in his specification of making his hose construction with the wire reinforcement in the crests of the external corrugations of the hose. In the Roberts method, an inner envelope is placed over

the inflatable mandrel and a reinforcing spring placed over the envelope. An outer envelope is positioned over the reinforcing spring to form the hose assembly. The mandrel is inflated into corrugated shape, thereby forming the inner envelope into corrugated shape also. For locating the wires in the troughs of the hose corrugations, the mandrel is inflated after the reinforcing spring has been covered by the outer envelope. For locating the wires in the crests of the corrugations, the mandrel is inflated prior to the outer cover being applied over the spring and inner envelope. Cement is applied between the inner and outer envelopes and the hose assembly is adhered together in corrugated shape by means of a forming strip wrapped down tightly against the troughs of the corrugations. When the hose assembly is adhered in corrugated form, the forming mandrel is deflated and the corrugated hose assembly removed for curing. This patent was specifically considered by the Patent Office in connection with the application for the '705 patent.

50. The Kort British patent (No. 227,373, accepted January 15, 1925) discloses the formation and vulcanization of a rubber hose. The patent does not disclose or suggest the use of any wire reinforcement in the hose or the formation of any corrugations therein.

51. All of the elements of product claims 1 and 2 of the '087 patent are not found in any single one of the four prior art patents applied against the claims. The Judson hose is not "interiorly . . . corrugated" and the outer surface of the hose is not "free of . . . added material" as recited in claim 1 of the '087 patent. In the Eames hose, all of the material is outside of the wire reinforcement and "the thickness of said material radially outwardly of said reinforcing means" is, therefore, *greater* than, not

"less than the thickness thereof radially inwardly of said reinforcing means," as recited in claim 1 of the '087 patent. In the Roberts '059 hose, the thickness of the material radially outward of the reinforcing means is "substantially the same" as the thickness thereof radially inward of said reinforcing means. Also, the Roberts '059 hose is not "mold-formed" but is hand-built and corded-down and the outer surface thereof is not "free of . . . added material," as recited in claim 1 of the '087 patent, since it has an outer fabric cover over the reinforcing spring. The Roberts '812 hose likewise is not "mold-formed" but is hand-formed in corrugated shape by a manually-applied forming strip. In addition, the outer surface of the Roberts '812 hose is not "free of . . . added material," as recited in claim 1 of '087, since it has an outer cover over the wire reinforcement. In the Roberts '812 hose, the thickness of the hose material radially outward from the wire reinforcement is "substantially the same" as the thickness radially inward.

52. All of the elements of method claims 1, 3 and 14 of the '705 patent are not found in any single one of the five prior art patents relied upon by defendant as against the relevant method claims of the '705 patent, namely, the patents to Eames, Judson, Harding, Voit and Roberts '812.

53. All of the elements of the relevant claims of the '087 and '705 patents or their equivalents are not found in any one single patent relied upon by the defendant where they do substantially the same work in substantially the same way to accomplish the same result. Thus, the inventions of the '087 and '705 patents are not anticipated by the prior art relied upon by defendant.

54. The burden of establishing that the claimed subject matter of the '087 and '705 patents as a whole was obvious

to one skilled in the flexible radiator hose art at the time the inventions disclosed and claimed in these patents were made is upon the defendant (35 U. S. C., § 282).

55. The Court has concluded that at the time the inventions disclosed and claimed in the patents in suit were made, these developments would not have been obvious to one skilled in the flexible radiator hose art. The Roberts '059 and '812 patents exemplify the prior art of hand-built fabric hoses. The Roberts '812 patent was merely another attempt to improve the prior art of hand-built hoses. Indeed, much of the work being done in this field at the time of the Caplan inventions is directed towards improvement in the hand-built fabric hose.

56. The Eames and Judson patents were over seventy years old at the time of the Caplan inventions. The age of these patents tends to negate any inference that the Caplan patents were obvious on the basis of these ancient patents.

57. Moreover, the Roberts '812 patent, including claim 16 thereof, was fully considered by the Patent Office in connection with the allowance of the relevant claims of the '705 patent in suit. This adds weight to the presumption of administrative correctness attached to the actions of the Patent Office in issuing the '705 patent and to the validity of the '705 patent itself.

58. The Court finds that the Caplan inventions, as exemplified in the '087 and '705 patents, would not have been obvious to a man skilled in the radiator hose art in 1953 to 1954. The combination of these isolated features of the prior art and original additions thereto, which produced the '087 and '705 patents, would not have been ob-

vious to one skilled in the radiator hose art. In this connection, it is relevant that the Caplan inventions enjoyed immediate and substantial commerical success. They increased the production rate of flexible radiator hoses significantly. Upon introduction into the market, they immediately began to replace the prior hand-built corded fabric hoses. Indeed, the defendant itself was a substantial customer of the Caplan hoses. Prior to the Caplan inventions, the defendant and many others made long and unsuccessful efforts to develop hoses of their own. The existing flexible rubber hoses were unsatisfactory, were expensive, and difficult to produce. There was a long-felt need for an improved and economical flexible radiator hose, and many individuals have attempted to produce one over an extensive period of time. The evidence of a long-felt need and substantial efforts by many individuals to produce an improved flexible radiator hose gives weight to the Court's inference and conclusion that the Caplan inventions would not have been obvious to a person skilled in the flexible radiator hose art in 1953 and 1954. Rather, the Court has concluded that the Caplan inventions were novel, creative, and inventive and were, indeed, surprising to those skilled in the art at the time they were developed.

II. Conclusions of Law

A. Validity

1. Claims 1 and 2 of the '087 patent and claims 1, 2, 3, 5, 6, 13, 14, 15 and 16 of the '705 patent carry a statutory presumption of validity arising from their issuance under 35 U. S. C. A., § 282.

2. The burden of establishing invalidity of claims 1 and 2 of the '087 patent and of claims 1, 2, 3, 5, 6, 13, 14, 15 and

16 of the '705 patent rests upon the defendant, and this burden has not been sustained by the evidence. 35 U. S. C. A., § 282; *Mumm* v. *Decker & Sons,* 301 U. S. 168 (1937); *Forestek Plating & Mfg. Co.* v. *Knapp Monarch,* 106 F. 2d 554 (6th Cir. 1939).

3. The presumption of validity attached to the issuance of claims 1, 2, 3, 5, 6, 13, 14, 15 and 16 of the '705 patent is further strengthened by the fact that these claims were allowed by the Patent Office after the Patent Office had fully considered the entire disclosure and claims of the Roberts '812 patent including claim 16 thereof, admittedly the most pertinent prior art reference relied upon by the defendant as to the '705 patent. *Williams Mfg. Co.* v. *United Shoe Machinery Corp.,* 121 F. 2d 273 (6th Cir. 1941).

4. Since all of the elements of claims 1 and 2 of the '087 patent and all of the steps of claims 1, 2, 3, 5, 6, 13, 14, 15 and 16 of the '705 patent could not be found in any one single patent, these claims are not invalid because of anticipation under 35 U. S. C. A., § 102; *Aluminum Co. of America* v. *Sperry Products, Inc.,* 285 F. 2d 911 (6th Cir. 1960); *Dewey & Almy Chemical Co.* v. *Mimex Co.,* 124 F. 2d 986 (2d Cir. 1942).

5. Claims 1 and 2 of the '087 patent and claims 1, 2, 3, 5, 6, 13, 14, 15 and 16 of the '705 patent are not invalid, under 35 U. S. C. A., § 102, based upon the prior art relied upon by the defendant as to said claims of the '087 and '705 patents.

6. Claims 1 and 2 of the '087 patent and claims 1, 2, 3, 5, 6, 13, 14, 15 and 16 of the '705 patent are not invalid because of alleged disclosure of the subject matter thereof by Robert E. Roberts or Fred T. Roberts, Sr., to the patentee,

David M. Caplan, or to any other employee of the W. J. Voit Company, or because of alleged prior invention by the said Robert E. Roberts or Fred T. Roberts, Sr., of the subject matter of said claims of the '087 and '705 patents.

7. The defense of prior invention must be established by evidence which is clear and convincing. *Barbed Wire Patent Case,* 143 U. S. 275 (1892); *Eibel Process Co.* v. *Minnesota & Ontario Paper Co.,* 261 U. S. 45 (1923); *Smith* v. *Hall,* 301 U. S. 216 (1937); *Cold Metal Products Co.* v. *E. D. Bliss Co.,* 285 F. 2d 244 (6th Cir. 1960); *National Latex Products Co.* v. *Sun Rubber Co.,* 274 F. 2d 224 (6th Cir. 1960).

8. The defendant's defense of alleged prior invention by Robert E. Roberts or Fred T. Roberts, Sr., as to the subject matter of claims 1 and 2 of the '087 patent, and as to the subject matter of claims 1, 2, 3, 5, 6, 13, 14, 15 and 16 of the '705 patent, and the alleged disclosure thereof to the patentee, David M. Caplan, and/or other employees of the W. J. Voit Company, has not been sustained by the evidence.

9. The defendant has failed to sustain any defense under 35 U. S. C. A., § 102, as against the claims of the '087 and '705 patents in suit.

10. Claims 1 and 2 of the '087 patent and claims 1, 2, 3, 5, 6, 13, 14, 15 and 16 of the '705 patent are not invalid under 35 U. S. C. A., § 103, because the differences between the subject matter of said claims and the prior art relied upon by the defendant are such that the claimed subject matter as a whole would have been non-obvious at the time the Caplan inventions were made to a person having ordinary skill in the radiator hose art. 35 U. S. C. A., § 103.

11. The inventions of the '087 and '705 patents enjoyed substantial commercial success; they filled a long-felt need for a better flexible radiator hose for the automotive replacement market; they substantially replaced in the trade the prior replacement radiator hose; and they achieved success in solving problems of long-standing in the prior hose, which solutions had eluded the industry, including the defendant. These factors are relevant in establishing that the claimed subject matter of the claims of the '087 and '705 patents was non-obvious. *Graham* v. *John Deere Co.*, 383 U. S. 1 (1966); *Goodyear Tire & Rubber Co., Inc.* v. *Ray-O-Vac Co.*, 321 U. S. 275 (1944); *Reiner* v. *I. Leon Co.*, 285 F. 2d 501 (2d Cir. 1960); *Mantle Lamp Co. of America* v. *George H. Bowman Co.*, 53 F. 2d 441 (6th Cir. 1931); *Simplicity Mfg. Co.* v. *Quick Mfg., Inc.*, 355 F. 2d 1012 (6th Cir. 1966).

12. The subject matter of claims 1 and 2 of the '087 patent, and of claims 1, 2, 3, 5, 6, 13, 14, 15 and 16 of the '705 patent was not obvious to a person having ordinary skill in the art of rubber radiator hoses at or prior to the time the inventions of said claims were made by the patentee Caplan, in or about the period 1953-1954.

13. Claims 1 and 2 of the '087 patent and claims 1, 2, 3, 5, 6, 13, 14, 15 and 16 of the '705 patent are valid.

B. Infringement

14. Claims 1 and 2 of the '087 patent have been infringed by the defendant by its manufacture and sale of defendant's flexible mold-formed radiator hose.

15. Claims 1, 2, 3, 5, 6, 13, 14, 15 and 16 of the '705 patent have been infringed by the defendant's method or

process of manufacturing its flexible mold-formed radiator hose in accordance with the method or process disclosed in the plaintiff's illustrative chart (PX 33) and in the Stipulation of December 10, 1966, and letter attachment thereto (PX 6).

16. There is no filewrapper estoppel resulting from any of the proceedings in the Patent Office during the prosecution of the application for the '087 patent, as shown by the filewrapper thereof, or otherwise, which would estop claims 1 and 2 of the '087 patent from being entitled to an interpretation and construction which would include within their scope the knit-reinforced, flexible mold-formed radiator hose manufactured and sold by the defendant.

17. There is likewise no filewrapper estoppel resulting from any of the proceedings in the Patent Office during the prosecution of the application for the '087 patent, as shown by the filewrapper thereof, which would estop claims 1 and 2 of the '087 patent from being properly entitled to an interpretation and construction which would include within their scope the arrangement and positioning of the coils of the wire coil reinforcing spring, as embodied in defendant's knit-reinforced flexible mold-formed radiator hose.

18. Claims 1 and 2 of the '087 patent are not limited to a so-called all-rubber flexible mold-formed radiator hose but are properly entitled to a construction and interpretation which includes within their scope the defendant's knit-reinforced flexible mold-formed radiator hose.

19. There is no filewrapper estoppel resulting from any of the proceedings in the Patent Office during the prosecution of the application for the '705 patent, as shown by the filewrapper thereof, or resulting from any of the proceed-

ings in or during the Robert v. Caplan Interference No. 91640, which would estop any of claims 1, 2, 3, 5, 6, 13, 14, 15 and 16 of the '705 patent from being properly entitled to an interpretation and construction which would include within their scope the defendant's method or process of manufacturing its knit-reinforced flexible mold-formed radiator hose.

20. Claims 1, 2, 3, 5, 6, 13, 14, 15 and 16 of the '705 patent are not limited to a method or process of making a so-called all-rubber flexible mold-formed radiator hose, as exemplified by PX 18 and 22, but are properly entitled to an interpretation and construction which includes, in all respects, defendant's method or process of making its knit-reinforced flexible mold-formed radiator hose.

21. Claims 1 and 2 of the '087 patent are properly entitled to an interpretation which includes within their scope the so-called all-rubber flexible mold-formed radiator hose made first by Voit and subsequently by Thermoid and plaintiff, as well as plaintiff's present longitudinal cord-reinforced flexible mold-formed radiator hose.

22. Claims 1, 2, 3, 5, 6, 13, 14, 15 and 16 of the '705 patent are properly entitled to an interpretation which includes within their scope the plaintiff's method of making the so-called all-rubber flexible mold-formed radiator hose made by Voit and then by Thermoid and plaintiff, as well as the plaintiff's method of making its present longitudinal cord-reinforced flexible mold-formed radiator hose.

23. Defendant's flexible mold-formed radiator hose comes clearly within the language and scope of claims 1 and 2 of the '087 patent, and defendant's hoses are for the same purpose and accomplish the same result in the same way

and by the same construction as the hoses defined in and by claims 1 and 2 of the '087 patent and infringement of said claims is thus established. *Graver Tank & Mfg. Co.* v. *Linde Air Products Co.*, 339 U. S. 605 (1950); *Great Lakes Equip. Co.* v. *Fluid Systems, Inc.*, 217 F. 2d 613 (6th Cir. 1954).

24. Defendant's method or process for manufacturing its flexible mold-formed radiator hose comes clearly within the language and scope of claims 1, 2, 3, 5, 6, 13, 14, 15 and 16 of the '705 patent; and defendant's method or process is for the same purpose, accomplishes the same result in the same way and by the same steps as the method or process defined in and by claims, 1, 2, 3, 5, 6, 13, 14, 15 and 16 of the '705 patent, and infringement of said claims is thus established.

25. Plaintiff has complied with all of the statutory requirements as to marking and notice as to the '087 and '705 patents under 35 U. S. C. A., § 287.

26. Plaintiff is entitled to the relief prayed for in the complaint herein including:

1. An accounting for damages, under the provisions of 35 U. S. C. A., § 284, suffered by the plaintiff by reason of defendant's infringement of claims 1 and 2 of the '087 patent and claims 1, 2, 3, 5, 6, 13, 14, 15 and 16 of the '705 patent.

2. An injunction order permanently enjoining the defendant, its officers, agents, servants, employees, and attorneys, and all those persons in active concert with them who receive actual notice of the injunction order by personal service or otherwise from:

(a) manufacturing, selling or using, or offering for sale, or use, or causing to be manufactured, sold or used, or offered for sale, defendant's flexible, knit-reinforced, mold-formed radiator hose, as exemplified by PX 9 and by PX 25A and PX 25B, or any flexible radiator hose embodying the construction of claims 1 and 2 of the '087 patent;

(b) manufacturing, selling, or using or offering for sale or use, or causing to be manufactured, sold or used, any flexible radiator hose in infringement of claims 1 and 2 of the '087 patent;

(c) otherwise directly or contributorily infringing claims 1 and 2 of the '087 patent, or either of said claims;

(d) practicing or causing to be practiced the process or method of making knit-reinforced flexible mold-formed radiator hose in accordance with the process or method employed by the defendant in the manufacture of its knit-reinforced flexible radiator hose, as exemplified by PX 9 and PX 25A and PX 25B, by the process or method disclosed in the plaintiff's illustrative chart, PX 33, and in the stipulation of December 10, 1966, and letter attachment thereto, PX 6, or by any process or method covered by claims 1, 2, 3, 4, 5, 6, 13, 14, 15 and 16 of the '705 patent:

(e) manufacturing or causing to be manufactured any flexible radiator hose by a method or process covered by claims 1, 2, 3, 5, 6, 13, 14, 15 and 16 of the '705 patent or any of said claims; and

(f) otherwise directly or contributorily infringing claims 1, 2, 3, 5, 6, 13, 14, 15 and 16 of the '705 patent or any of said claims; and

3. A judgment in accordance herewith.

/s/ THOMAS D. LAMBROS,
*United States District Judge.*

# APPENDIX B

## RULES AND STATUTES

**(1) Rule 205(b)—Patent Office Rules of Practice:**

Where an applicant presents a claim copied or substantially copied from a patent, he must, at the time he presents the claim, identify the patent, give the number of the patented claim, and specifically apply the terms of the copied claim to his own disclosure, unless the claim is copied in response to a suggestion by the Office. The examiner will call to the Commissioner's attention any instance of the filing of an application or the presentation of an amendment copying or substantially copying claims from a patent without calling attention to that fact and identifying the patent.

**(2) 28 U.S.C. § 2101 (c)**

Any other appeal or any writ of certiorari intended to bring any judgment or decree in a civil action, suit or proceeding before the Supreme Court for review shall be taken or applied for within ninety days after the entry of such judgment or decree. A justice of the Supreme Court, for good cause shown, may extend the time for applying for a writ of certiorari for a period not exceeding sixty days.

**(3) 35 U.S.C. § 103**

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having

ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

**(4) 35 U.S.C. § 121**

If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions. If the other invention is made the subject of a divisional application which complies with the requirements of section 120 of this title it shall be entitled to the benefit of the filing date of the original application. A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a reference either in the Patent Office or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application. If a divisional application is directed solely to subject matter described and claimed in the original application as filed, the Commissioner may dispense with signing and execution by the inventor. The validity of a patent shall not be questioned for failure of the Commissioner to require the application to be restricted to one invention.

**(5) 35 U.S.C. § 282**

A patent shall be presumed valid. Each claim of a patent (whether in independent or dependent form) shall be presumed valid independently of the validity of other claims; dependent claims shall be presumed valid even though dependent upon an invalid claim. The burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting it.

* * *